Supreme Court, U.S.
FILED

011724 MAY 20 2002

OFFICE OF THE CLERK

No. 02-

IN THE

Supreme Court of the United States

Dr. Genick Bar-Meir,

Petitioner

v.

North American Die Casting Association

On Petition For Writ Of Certiorari To The
United States Court of Appeals for the Eighth Circuit

PETITION FOR WRIT OF CERTIORARI

Dr. Genick Bar-Meir
1107 16th Ave S.E.
Minneaplis, MN 55414-2411
(612) 623-0713

QUESTIONS PRESENTED

The Lanham Act U.S.C. § 15 restricts/prohibits use of trademark of "confusedly similar" marks. The question presented is whether a trademark holder can bring evidence and alleged "actual confusion" by alleging that the holder (or his "employees") is confused.

For the purpose of the trademark analysis a several factors test is used to examine whether the (trademark) marks are confusingly similar. Different circuits have different numbers of factors (and also different factors) in their "standard" test. Even-though the test supposed to be flexible, changing the factors of the test put additional burden on the moving party. The question present is whether a national test should be used standard factors. Further, when a party would like to add additional factors should the change put addition burden on the moving party.

Some circuit courts ignore the "market character and size[1]" as a factor. The question presented is whether the "target market its character and its size" and "parody" factors be ignored in the analysis of the present case.

[1] All the circuit courts ignore size factor, and only addressing the future expansion of the market.

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

The parties to the proceedings in the United States Court of Appeals for Eighth circuit were the petitioner Dr. Genick Bar-Meir and North American Die Casting Association. None of these parties is either publicly held or affiliated with any entity that is so held.

TABLE OF CONTENTS

QUESTION PRESENTED i

STATEMENT PURSUANT TO RULE 29.6 ii

TABLE OF CONTENTS iii

TABLE OF CITED AUTHORITIES iv

TABLE OF APPENDICES vi

OPINIONS BELOW 1

STATEMENT OF JURISDICTION 1

STATUTORY PROVISIONS INVOLVED 1

STATEMENT OF THE CASE 1

REASONS FOR GRANTING THE WRIT 16

APPENDIXES 19

TABLE OF CITED AUTHORITIES

CITED	page
Adelman-Tremblay v. Jewel Cos., Inc., 859 F.2d 517, 521 (7th Cir. 1988)	15
Aktiebolaget Electrolux v. Armatron Int'l, Inc. , 999 F.2d 1, 2-3 (1st Cir. 1993)	8
Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 1160 (5th Cir. 1982);	12
Bank of Illinois v. Allied Signal Safety Restraint Systems, 75 F.3d 1162 (7th Cir. 1996)	15,15
Camfield Tires, Inc. v. Michelin Tire Corp., 719 F.2d 1364 (8th Cir. 1983).	16
Darnell v. Target Stores, 16 F.3d 174, 176 (7th Cir. 1994)	15
Dranoff-Perlstein , 967 F.2d at 862-63 (3d Cir.1992)	8
Duluth News-Tribune v. Mesabi Publishing Company, 84 F.3d 1093, 1096 (8th Cir. 1996)	12
Elvis Presley Enterprises, Inc. v. Barry Capece, 141 F.3d 188, 193 (5th Cir. 1998)	7
First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987)	10
Ford Motor Co. , 930 F.2d at 293	8
FunDamental Too, Ltd. v. Gemmy Ind. Corp., 111 F.3d 993, 1003-04 (2d Cir. 1997);	12
Garnac Grain Co. v. Blackley, 932 F.2d 1563 (8th Cir. 1991)	16
Gruner + Jahr USA Publ'g v. Meredith Corp., 991 F.2d 1072, 1075 (2d Cir. 1993)	8
International Kennel Club of Chicago, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1090-91 (7th Cir. 1988);	12

CITED	page
Jordache Enterprises, Inc. v. Hogg Wyld,..... Ltd., 828 F.2d 1482, 1487 (10th Cir. 1987)	11,12
Lapp , 721 F.2d at 463	8
Mutual of Omaha v. Novak, 836 F.2d 397,..... 399 n. 3 (8th Cir 1987)	5
N.L.R.B. v. Town & Country Elec, Inc., et..... (94-947), 516 U.S. 85 (1995)	13
Perini Corp. v. Perini Constr., Inc., 915 F.2d..... 121, 127 (4th Cir. 1990))	9
Pizzeria Uno , 747 F.2d at 1527	9
Polaroid Corp. v. Polarad Elecs. Corp., 287..... F.2d 492, 495 (2d Cir. 1961))	8
San Francisco Arts & Athletics, Inc. v..... United States Olympic Comm. , 483 U.S. 522, 564 (1987)	11
Russell v. Acme-Evans Co., 51 F.3d 64, 67..... (7th Cir. 1995)	15
Rust Env't & Infrastructure, Inc. v. Teunis-..... sen, 131 F.3d 1210, 1216 (7th Cir. 1997)	10
Scott Paper , 589 F.2d at 1229.	8
Smith Fiberglass Products, Inc. v. Ameron,..... Inc., 7 F.3d 1327, 1329 (7th Cir. 1993)	10
Tally-Ho, 889 F.2d at 1027; Freedom Sav. &..... Loan Ass'n v. Way, 757 F.2d 1176, 1182 (11th Cir.)	11
Universal Money Ctrs., Inc. v. American Tel..... & Tel. Co., 22 F.3d 1527, 1530 (10th Cir. 1994)	10
Warner Bros., Inc. v. Gay Toys, Inc. , 658..... F.2d 76, 79 (2d Cir. 1981))	9

TABLE OF APPENDICES

CITED	page
Judge Kyle's Order referring to Magistrate Judge dated Feb 15, 2001.	1a
Magistrate Judge's Order dated Mar. 27,	2a
Judge Kyler's Order dated Apr. 16, 2001	13a
Magistrate Judge's Order dated May 11, 2001	14a
Extracts form the hearing on the bad faith motion	18a
Petitioner's motion in regards to providing Bad Faith affidavits	19a
Magistrate Judge's Amended Report and Recommendation dated May 21, 2001.	30a
Magistrate Judge's order dated June 12, 2001	51a
Judge's Kyle affirmed the R&R	54a
Judge's Kyle denied stay order	56a
Judge's Kyle administrative order	57a
The appeal court affirm the district court order	58a
Walker declaration	60a
Extracts from Walker deposition	62a
The correspondence that Walker alleged to be confusing	65a
The Allen's letter before he got confused	73a

PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully petition for writ of certiorari to review the judgment of the United States Court of Appeals for the Eighth Circuit in this case.

OPINION BELOW

The opinion of the United Court of Appeals for the Eighth circuit (per BOWMAN, BRIGHT, and LOKEN) (January 10, 2002) and the order denying the petition for rehearing and for rehearing en banc are unpublished (on February 19, 2002) (Pet. App. 58a). The order and opinion of the district court (Honorable Richard H. Kyle) is at Bar-Meir v. North American Die Casting Association Docket number 00-1666 U.S. Distrcit of Minnesota (filed Jul 12, 2000) (Id 54a). The amended report and recommendation of the Honorable Magistrate Judge Susan Nelson is not reported (Id 30a).

STATEMENT OF JURISDICTION

The court of appeals entered its opinion and order on and denied rehearing and rehearing en banc on Feb. 19, 2002. This Court has jurisdiction over this petition under 28 § 1254 (1).

STATUTORY PROVISIONS INVOLVED

The provisions of the Lanham Act 15 U.S.C. 1051 et seq, relevant to this petition are reprinted in the Appendix at 74.

STATEMENT OF THE CASE

Petitioner purchased the web site name "nadca.org" on August 1999 and start to operate the web site on November 10, 1999. In December 1999, some negotiations conducted between the petitioner to respondent merely to stop the operation and the offering of the information that was on the web site (no discussion on transfer the web site name **ever** (emphasis added) occurred.). Some time in April 2000 the Respondent filled a complaint with

WIPO. The Arbitrator concluded, without whatsoever any analysis, that the names are similarly confusing, that the web site name should be transfered. Following this decision, petitioner moved the case to the Federal District Court. The Respondent immediately moved for a summary judgment. The district court adapted the amended report and recommendation of the Magistrate Judge dated May 12, 2001 on June 12 2001.

The Report and Recommendation is based on affidavits of three individuals who were/are the president, governor, and a committee member affiliated with the respondent. Also the Report and Recommendation is based the 6 factors test. Many of the "facts" the Magistrate Judge held the Report and Recommendation were conceded by the Respondent to be not true, such as, what are the kind the petitioner's email, the fact the petitioner never sent his book to respondent for review etc.

The petitioner argues among other things that the target market character and size are the dominate factor that should be considered in the analysis. It is undisputed that the number of the "target market" is less than 6000 individuals[2]. It is undisputed that everyone, in the "target market," either was in the web site several times or is choose not to visit the web site. The Magistrate report implicitly held that the "target market" factor is irrelevant, ignoring the petitioner's argument. This conclusion upheld by the Eighth Circuit.

The respondent's main argument was that there is "actual confusion" in the confusingly similar test. The alleged "actual confusion" is based on affidavits of three individuals who are the president, and member of board of governor, and an "affiliated" member. The petitioner argued[3] that these affidavits are controversial, at the very minimum, and the individuals who are actually a party cannot provide information on "actual confusion." Further, these declarations are used to prove that all the other factors are in favor of the respondent. Petitioner believes that these evidence should be considered as hersey.

---

[2]The respondent actually put the number on 4000 which was the pick number of its membership.

[3]And petitioner filed a Motion for providing bad faith affidavits pursuant to Federal Rule 56(g). (see App. 19a)

In fact, the record shows that these individuals were involved in shutdown of the petitioner's site from its conception. It is uncontested, that these three individuals were in the petitioner's web site numerous times before the alleged confusion. Furthermore, it is uncontested declarants have numerous discussions about the petitioner prior to the confusion. Now, the question is can the respondent (as a corporation) present individuals who are his "employees" (the president of the corporation, governor, committee member) as a proof of a actual confusion factor and other factors? The district court held (and it was upheld the appeal court) that this issue "merit-less." (See for amended report and recommend p. ??a stating that motion for providing bad faith affidavit is without any merit. (see page 16 see also for the correspondence that Walker alleged confusing him at page 65) In a deposition,[4] the president, during the relevant time, made statements that conflict with the previous declaration that was provided for the Judgment Summary[5]. (For more information see the Petitioner's Memorandum for providing bad faith affidavits App. p. 19.[6]) Clearly, after the president sent his demanding letter 68 to the petitioner, he was aware who is the petitioner and it put all his declaration, at the very least, in a big question.

The Magistrate Judge held that individuals were actually confused regardless to the fact that they were actually the respondent (or at least the "employees"). The Eighth Circuit upheld this view. Furthermore, the Magistrate Judge held that individuals confused regardless to the fact that the individuals' declarations conflict with other evidence. The appeal court upheld district decision. This view conflicts with the view of other circuits holding that a party itself cannot testify on the behalf of the market as a proof of actual confusion.

---

[4]The deposition conducted on April 15, 2002 (See App. p. 62)

[5]For example, at affidavit the president made the allegations that he was confused by a book in December 1999. While in the deposition, the president was sure that he was confused rather from announcement for the class that was in end of February 2000. This confusion occurred after president sent a letter to petitioner demanding that petitioner will leave the field.

[6]The Magistrate held that the petitioner has brought the motion according to Fed. Rule 11 despite the petitioner insistence that it was brought according the rule 56(g). compere Magistrate Judge finding in page 15 with the hearing transcript at p. 18.

The parties

The petitioner is a scientist in the field of Heat transfer and specialized in die casting process. The petitioner spend his 15 years to study the die casting process. The respondent is North American Die Casting Association which "represent" about 2000 individuals from about 4000-6000 die casting community. It is disputed what is the real mission of the respondent.

During of his study, the petitioner discovered that what commonly believe to be true is violating established scientific principles. At first, respondent's position was that Dr. Bar-Meir's research is erroneous and tried to prevent the publication of such research in any means. Later, the respondent adopted the position that Dr. Bar-Meir's research is co-existent with the respondent's sponsored–research. Be it as it may, it is indisputable that there is controversy about research conducted/sponsored/associated with the respondent.

Background

The Respondent had continued to try to block the publication of the research, ideas, and information as possible. According to the information that Responded provided, about 15% of its member left its organization after the petitioner's web site opened. Thus, the extreme interest of the respondent is to block petitioner's web site as must as possible. The Respondent never make the allegation that members have seceded the membership because alleged confusion with web site. Nevertheless, couples of months after the transfer of the web site name,[7] additional (over 700) individuals (over 17%) left the Respondend (by the time appeal court rendered its decision.). Since the appeal court decision, hundreds more have left the respondent. Clearly, the mass desertion of the Respondent is not due to the confusion but rather due to "air" of petitioner's opinion about the respondent's research/teaching/conduct. The respondent could not produce even a single case that a member left the respondent because he or she got confused or because confusion. The respondent could

[7]Pursuant to appeal court decision denying stay petitioner's Motion. The petitioner transfered the web site. The web site name "nadca.org" became under the control of Respondent.

not point to a single[8] case where as a result of the confusion anyone did not use a service or a product of the respondent.

As initial matter, the adaption of the name "nadca.org" was results of search to find a name for the web site which include the words "die casting" in it. The limit possibility lead to find the name of "nadca.org." It was obvious that "nadca.org" not confusing since the undisputed fact that the Respondent was very actively advertising that the "nadca.(com, org), prior to registration of "nadca.org," is not North American Die Casting Association. It occurred the possibility that the adaption of the name "nadca.org" will irritate to Respondent. In fact, the petitioner eMail like Respondent president Mr. Walker (see p. 65 proof not intend to "pass off" but rather emphasis his identity. At first, the adaption of the name "nadca.org" was portray North American Die Casting Association as a "klutz", it turnout that people view the Respondent as organization that not only abuse the federal research money but also as a joke. These facts are supported by the undisputed facts that Respondent was not concerned initially with web name "nadca.org" but rather attempt to close the web site at any cost. Petitioner's offered several times to have "nadca.org" transfered to the Respondent after a transition of time, offer which was rejected.

Which factors should be used in the confusingly similar?

Different appeal courts use different factors for the "confusingly similar" test. It is recognized by some courts that their factors are not exclusive and every case should considered based on its peculiarity situation in regards to the factors. In fact even the Eighth Circuit states in Mutual of Omaha v. Novak, 836 F.2d 397, 399 n. 3 (8th Cir 1987) that "[T]hese are not necessarily the only factors that might be relevant in a particular case. The ultimate inquiry always is whether, under all the circumstances, there exists a likelihood of confusion between the plaintiff's trademark and the allegedly infringing use." Notwithstanding this statement, the Eighth Circuit uses almost exclusively utilize the six factors test.

The Eighth Circuit state that the factor in the present case are (see Luigino's, Inc. v. Stouffer Corp., 170 F.3d 827, 830

[8]Even plainly to allege a single case.

(8th Cir. 1999) .) (1) the strength of the owner's mark; (2) the similarity of the owner's mark and the alleged infringer's mark; (3) the degree of competition between the products; (4) the alleged infringer's intent to "pass off" its goods as the trademark owner's; (5) incidents of actual confusion; and, (6) the type of product, its cost, and conditions of purchase. The petitioner attempt to absorb other factor in to the Eighth Circuit test but unsuccessfully.

The petitioner has collected all the test factors that were found in all the cases the common (hereinafter referred as the "constant factors") factors are

(1) Actual confusion;

(2) Strength of senior user mark; and

(3) Similarity of the Marks.

All the other factors appear in some and omitted in others. The Summary of all the factors that petitioner found are summarized below (including the "constant factors";

(1) Strength of the mark;

(2) Similarity of the marks;

(3) Competition between the parties;

(4) Likelihood to bridge the gap ...;

(5) Actual confusion;

(6) The length of usage without actual confusion;

(7) Good faith in adopting the mark;

(8) Quality of the products;

(9) Sophistication of the Buyers;

(10) Class of prospective Purchasers;

(11) Channels of trades (or distribution); Other also called it similarity of the facilities of transact;[9]

(12) Similarity in advertising;

(13) Price of goods and care of Customers;

(14) The relationship of the goods in the minds of consumers;

(15) The future expansion of the products;

(16) Geographical extent (overlapping areas of service);

(17) The Degree of recognition of the mark in the trading areas and channels of trades used;

(18) The nature and extent of use of the same or similar marks by third parties;

(19) Parody;[10] and

(20) The fame of the senior and the fame of the Junior user of the mark;

It can be shown that some overlapping between the mark exist. For example factors (8) and (12) have same similarity but they are not the same. In factor (8) the buyers can be sophistocated but they do not pay attention for the details and can be unsophisticated buyers who pay attention to the details (like to every tomato is checked). Nevertheless, it can be shown that test by different standard will yield different results. Furthermore, it can be shown that even with the overlapping two test cover different aspects. In some instances, two completely different tests can produce the same result while in other cases the results are different. For example, in the present case, including the factor of character of the field[11], quality of the product, sophistication of the buyers, relationship of the goods in the minds of consumers,

[9]these items almost identical, however the petitioner believes that they are not similar, yet they are combine here.

[10]Elvis Presley Enterprises, Inc. v. Barry Capece, 141 F.3d 188, 193 (5th Cir. 1998)

[11]Petitioner believes that another factor argue the another factor should be added to the list and it is the size of the market.

degree of recognition of the mark channels of trade used, the nature and extent of use of the same or similar marks by third parties, and parody (etc.) definitely favor the petitioner. Other factors in the present case are neutral and other might favor the respondent[12]. The most important point in this case is that the character and size of the market must make a difference in this case. Clearly these factors must tilde the balance[13]. One can argue that some of the factors can be absorbed by others. The fact is that this absorption is most cases is not allowed. For example in this case the character of the field or parody factors never became part of the analysis.

Here is the list of the summary of the factors that are used by various Circuit court as a test.

The first circuit is using eight factors test (See, Aktiebolaget Electrolux v. Armatron Int'l, Inc. , 999 F.2d 1, 2-3 (1st Cir. 1993);
1) Similarity of Marks: 2) Similarity of Goods: 3) Advertising; 4) Channels of Trade; 5) Class of Prospective Purchasers; 6) Evidence of Actual Confusion: 7) Defendant's Intent in Adopting the Mark; 8) Strength of the Mark.

The second circuit also is using eight factors test (See, Polaroid Corp. v. Polarad Elecs. Corp. , 287 F.2d 492, 495 (2d Cir. 1961)) and Gruner + Jahr USA Publ'g v. Meredith Corp. , 991 F.2d 1072, 1075 (2d Cir. 1993): (1) the strength of the mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will 'bridge the gap' . . . ; (5) actual confusion; (6) the defendant's good faith in adopting its mark; (7) the quality of the defendant's product; and (8) the sophistication of the buyers.

The third Circuit is using (See, Dranoff-Perlstein , 967 F.2d at 862-63 (3d Cir. 1992) ; Ford Motor Co. , 930 F.2d at 293; ; Lapp, 721 F.2d at 463 Scott Paper , 589 F.2d at 1229.) (1)

---

[12]Petitioner does not agree with analysis of the Magistrate Judge, among other things, the many "facts" that Magistrate Judge were conceded on the appeal by the Respondent to be in the opposite.

[13]For example, if there is only one person in the potential market and this person know both party he will not get confused.

degree of similarity between the owner's mark and the alleged infringing mark; (2) the strength of the owner's mark; (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; (4) the **length of time** (emphasis added) the defendant has used the mark without evidence of actual confusion arising; (5) the intent of the defendant in adopting the mark; (6) the evidence of actual confusion; (7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media; (8) the extent to which the targets of the parties' sales efforts are the same; (9) the relationship of the goods in the minds of consumers because of the similarity of function; and (10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market, or that he is likely to expand into that market.

In the fourth Circuit is factors include (See Pizzeria Uno , 747 F.2d at 1527; see also Perini Corp. v. Perini Constr., Inc. , 915 F.2d 121, 127 (4th Cir. 1990)) (1) the distinctiveness of the senior mark; (2) the similarity of the two marks; (3) the similarity of the goods or services that the marks identify; (4) the similarity of the facilities employed by the parties to transact their business; (5) the similarity of the advertising used by the parties; (6) the defendant's intent in adopting the same or similar mark; and (7) actual confusion.

The fifth Circuit the factors includes (See,

(1)strength of the registrant's mark; (2)relatedness of the services; (3)similarity of the marks; (4)evidence of actual confusion; (5)marketing channels used; (6)likely degree of purchaser care and sophistication; (7)intent of the defendant in selecting the mark; and (8)likelihood of expansion of the product lines using the marks.

The six Circuit use (See Warner Bros., Inc. v. Gay Toys, Inc. , 658 F.2d 76, 79 (2d Cir. 1981)) (1)strength of the registrant's mark; (2)relatedness of the services; (3)similarity of the marks; (4)evidence of actual confusion; (5)marketing channels used; (6)likely degree of purchaser care and sophistication; (7)intent of the defendant in selecting the mark; and (8)likelihood of

expansion of the product lines using the marks.

In the seventh Circuit the following factors are used: Smith Fiberglass Products, Inc. v. Ameron, Inc., 7 F.3d 1327, 1329 (7th Cir. 1993) (See also Rust Env't & Infrastructure, Inc. v. Teunissen, 131 F.3d 1210, 1216 (7th Cir. 1997): (1) similarity between the marks in appearance and suggestion; (2) similarity of the products; (3) area and manner of concurrent use; (4) degree of care likely to be exercised by consumers; (5) strength of complainant's mark; (6) actual confusion; and, (7) intent of defendant to "palm off his product as that of another."

The ninth Circuit uses (See First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987): (1) the degree of inherent or acquired distinctiveness of the mark; (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (3) the duration and extent of advertising and publicity of the mark; (4) the geographical extent of the trading area in which the mark is used; (5) the channels of trade for the goods or services with which the mark is used; (6) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought; (7) the nature and extent of use of the same or similar marks by third parties; and (8) whether the mark was registered . . . on the principal register.

The tenth Circuit is using (See Universal Money Ctrs., Inc. v. American Tel. & Tel. Co. , 22 F.3d 1527, 1530 (10th Cir. 1994) the following (1)the degree of similarity between the marks, including the marks' appearance, pronunciation, suggestion, and manner of display; (2)strength or weakness of the plaintiff*s mark; (3)the intent of the alleged infringer in adopting its mark; (4)similarities and differences of the parties' goods, services and marketing strategies; (5)the degree of care likely to be exercised by purchasers of the goods or services involved; and (6)evidence of actual confusion, if any.

Even though this Court has used in some cases additional different factors a) fame of the senior mark; and b) fame of the junior mark

The eleventh factor are (See Tally-Ho, 889 F.2d at 1027; Freedom Sav. & Loan Ass'n v. Way, 757 F.2d 1176, 1182 (11th Cir.): (1) the type of mark; (2) the similarity of the two marks; (3) the similarity of the goods; (4) the identity of customers and similarity of retail outlets, sometimes called the similarity of trade channels; (5) the similarity of advertising; (6) the intent, i.e., good or bad faith, of the alleged infringer; and (7) evidence of actual confusion, if any.

"Confusion occurs when consumers make an incorrect mental association between the involved commercial products or their producers." (San Francisco Arts & Athletics, Inc. v. United States Olympic Comm. , 483 U.S. 522, 564 (1987) (Brennan, J., dissenting))). Jordache Enterprises, Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1487 (10th Cir. 1987)

The question is whether the confusion (similarly) in the web is the a same for a small markert (as the die casting field) as large market? It is undisputed that the general public have no idea what is die casting not to mention what is the North American Die Casting Association. In the small field of the die casting every one know that North American Die Casting Association is not associated with nadca.com or nadca.org. It is undisputed that the Respondent **actively** advertise that respondent is not associated with these web sites.

The respondent only assert its association with only the web site "diecasting.org."[14] The publication of the mark "NADCA" in a hard copy direct to the die casting community will be associated with the respondent. In the Internet the mark "nadca" or "NADCA" are not distinctive. In the communication with the die casting community via the Internet in the light of the forgoing fact is also not distinctive. Note the petitioner does not use the mark outside the Internet context.

For example, in Mr. Allen's letter to Mr. Twarog dated December 9, 1999 (see p. 73a) "I always wondered why we didn't have "NADCA.com" or "NADCA.org" nailed [sic] down. Now I

[14] At the very least, until the transfer of the name the North American Die Casting Association's marketing director went to all the places and to joke that nadca.com is not respondent.

know!" Mr. Allen and others alway knew that nadca.(com,org) is not North American Die Casting Association. By this sentence also demonstrates that Mr. Allen is not out side of North American Die Casting Association. The use of **we** (emphasis added) is part of North American Die Casting Association.

Hersey

The declaration of individuals in the analysis of the confusingly similar play a significant role in the Magistrate Judge's R&R. In fact the everyone of the declarants is mentioned about 20 times. Many of the issue that were held by the Magistrate Judge as facts, were found on the appeal to be the contrary. Among the "corrected" facts are the kind of Emails the petitioner sent and to whom, the fact the petitioner never send his book to the respondent, etc. The Magistrate Judge held that even though that the declaration are from the respondent "employees" their testimony is not to be considered as hersey. Generally it settled that a party which is an individual cannot testified on actual confusion. Further, all the Circuits do accept that the evidence of the declaration of employee's as hersey. The Second, Fifth, Seventh, and Tenth Circuits have made special exception for the state of mind See FunDamental Too, Ltd. v. Gemmy Ind. Corp., 111 F.3d 993, 1003-04 (2d Cir. 1997); Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 1160 (5th Cir. 1982); International Kennel Club of Chicago, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1090-91 (7th Cir. 1988); Jordache Enterprises, Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1487 (10th Cir. 1987). The declarations of some individuals without cross examination was considered as hersey and was rejected by the Eighth Circuit Duluth News-Tribune v. Mesabi Pub. Co., 84 F.3d 1093, 1098 (8th Cir. 1996). The Sixth Circuit and this Court had no position on this issue.

Nonetheless, the Eighth Circuit in this case uphold different opinion but did not explain why. The only plausible explanation to this opinion, can based on the fact that declarants were "volunteered" employees of the respondent. The declarants were the president, governor, and a committee member. Perhaps the allegations that they were not paid directly "convert" them to be in

"no–employees." In N.L.R.B. v. Town & Country Electric Inc., U.S. Sup. Ct. (November 28, 1995) the unanimous court stated that even paid union are to be considered as employee. However, the holding of the Eighth circuit interpretation of the definition of "no employee" for the purpose of the determination of hersey is to broad. The three declarants have all kind of benefits as results of the positions they hold in the respondent. Regardless to the position of this Court in regards to the "employment" of the declarant, the nexus the declarants have with the respondent must make their declarations equivalent to hersey. The fact the every decision made by the respondent has to be approved by them, et cetera, clearly mean they are not independent bystander who offer testimony of actual confusion.

Traditionally, the courts look at several factors, including the nature of the compensation paid, provision for employee benefits, whether the hired party is in business, tax treatment of the hired party, source of the equipment used, and location of the work. In the contact of the hersey, this test show that the declarant had, compensation and where hired (volunteered) in the respondent business and source of the equipment is mostly of the respondent (during the meeting paid by the respondent) and, the location was in the respondent control (hotels for the meeting that were paid by the respondent) while the factor regarding the tax and employee benefits at the very best favor the respondent. Even according to this test the declarants were "employee."

The confusing letter[15] to announce of the class cannot be (even remotely) constructed as intent to pass off. Here what appear in the letter:

> "Free On Line Die Casting Design Classes
>
> Here is what the North American Die Casting Association claim: " their teaching is almost as good as ours(check www.nadca.org/coverup.html)." YOU

[15]Is letter what make the actual confusion? At first the allegation was on a letter in December, just to change to this letter in February. (see the entire correspondence p. 65)

> WILL BE JUDGE! Network Advance Die Casting Assistance is proud to offer free classes to die casting engineers and die casting community in general. The first class to be offered is: "Introduction to runner system design." All you have to do is to register the class before March 27, 2000 via email.
>
> Class notes will be email to you. You can send questions or/and discussions to Dr. Bar-Meir. There is a limit on the number of the students. So please register as early as possible.
>
> Tentative Classes to follow:
>
> intermediate runner design"

...

How this letter can be constructed as to pass off as North American Die Casting Association? It is simply cannot.

The actual confusion factor is the most amplified example why there is an genuine factual dispute. If the affidavits at question are strike out there is not actual confusion and the most prominent factor from the analysis evaded and the petitioner believe the Court will tilde the balance to his favor. The fact the Respondent needed to provide affidavits which contradict uncontested factors, from individuals who are part of Respondent[16] demonstrates that there is no confusion at all. If there was any real confusion, the Respondent could find about it and present it to the court. However, since the Respondent resort in using his president, board of Governors, and previous president it is like saying that Respondent himself was confused who is who which the evidence show not to be true.

Furthermore, the Court should give very minimal weight to this hersey evidence. Especially in cases where all the evidence requested on these individuals were claimed to be privileged and no evidence was provided such communication between Mr. Skoff and Respondent to substantiated the allegations. In fact, the

[16]They refers to themselves as we when talking to Respondent.

Respondent's memorandum of damages does not show even a single case of actual damages.

The petitioner requested information on the communication between Mr. Walker and Respondent and none was provided. The Lower Court found this communication to irrelevant (and perhaps privilege). However, the fact remained that this vail did not allow even the minimal examination of the affidavits. Now, when these affidavits are totally conflicting with other information particularly evidence that were provide by the Respondent, these affidavits must be treated without any weight and as this Court threats other hersey evidence.

The appellant would like the Court to examine far more detail information on the contradiction from the attached petitioner's Motion to the district Court and would like to present only several "nuggets." Seventh circuit found in the case Bank of Illinois v. Allied Signal Safety Restraint Systems, 75 F.3d 1162 (7th Cir. 1996) that when the plaintiff was contradicting his earlier statements, the statements were given no weight. "The purpose of summary judgment motions - 'to weed out unfounded claims, specious denials, and sham defenses,' - is served by a rule that prevents a party from creating issues of credibility by allowing one of its witnesses to contradict his own prior testimony." Adelman-Tremblay v. Jewel Cos., Inc., 859 F.2d 517, 521 (7th Cir. 1988) . Courts are "highly critical of efforts to patch up a party's deposition with his own subsequent affidavit" (Russell v. Acme-Evans Co., 51 F.3d 64, 67 (7th Cir. 1995) (Posner, C.J.)), especially where (as here) those efforts crop up in the context of summary judgment, because "such an affidavit is not difficult to produce," Bank of Illinois v. Allied Signal Safety Restraint Systems, 75 F.3d 1162, 1173 (7th Cir. 1996) (Cudahy, J., concurring). "Inherently depositions carry an increased level of reliability" (Darnell v. Target Stores, 16 F.3d 174, 176 (7th Cir. 1994)) compared to affidavits; "[d]epositions are adversarial in nature" (ibid.), whereas affidavits are "drafted by the lawyers." Russell, 51 F.3d at 67. Accordingly, "when a witness has contradicted directly his or her own earlier statements without explaining adequately the contradiction or without attempting to resolve the disparity," the affidavit is properly disregarded. Bank of Illinois, 75 F.3d at 1168. Applying these well-settled principles,

the appeal court should strike the made-for-summary-judgment affidavits of Walker, Allen, and Skoff. See also Camfield Tires, Inc. v. Michelin Tire Corp., 719 F.2d 1364 (8th Cir. 1983). In fact there is a garden of cases in which contradiction are taken very seriously (see also Garnac Grain Co. v. Blackley, 932 F.2d 1563 (8th Cir. 1991). In this case, Mr. Allen send eMail to Mr. Twarog stating that the petitioner's letter is so inflammatory like never before. Only later Mr. Allen allege in his affidavit that he was confused by very same latter. Clearly his whole affidavit should be consider for bad faith provision of Federal Rule 56 (g). Mr. Allen's affidavit contradicts numerous other facts which explained in the attached as an exhibit Memorandum (App. p. 19a and the letter itself is in p. 73a) to District Court.

In the case of Mr. Walker it is even more severe contradictions. Mr.Walker was confused by eMail offering a class before the class was offered. In his deposition a month ago (app. p. 62), he retracts from that statement. Later at the hearing the attorney suggest that somehow Mr. Walker has amnesia and he was confused about the time. However, the Court will accept this explanation, the fact remain that Mr. Walker install in his company a filter system just to remove/prevent the petitioner's letter. At the hearing the Attorney somehow suggest that perhaps someone else sent the email to Mr. Walker and that person never told Mr. Walker where is the original eMail come from. If that is correct why the Respondent never brought the original person "the good Samaritan" as example of actual confusion but resort in using "secondary" confusion when the existence of "genuine confusion" is exist. The confusing letter is very same as the one that is typed earlier in this memorandum on page 14. In the case of Mr. Twarog, the affidavit for Summary Judgment contradicts his previous affidavit. In one affidavit Mr. Twarog claims that he was aware of the eMail some time in March or April 2000 about the petitioner's eMail messages. Mr. Twarog made this claim to support his allegation that petitioner attempts to portray himself as North American Die Casting Association. However, in his letter to his friend Mr. Allen dated December 10, 1999 Mr. Twarog admits to receive Dr. Bar-Meir's letter dated December 5, 1999.

REASONS FOR GRANTING THE WRIT

The Eighth Circuit's holding that the test for "similarity confusing" should not include the size and the character of the market conflicts with other circuits holding. Further, the Eighth Circuit's holding that declaration of the respondent's "employee" does not fail into the hersey category conflicts with other Circuit Courts. The Eighth Circuit's holding results in a creation of a situation where the results of the six factors test determine the trademark to be confusingly similar while the reality is the opposite. Furthermore, every party which is a corporation has to do is simply "ask" their board of directors to allege actual confusion just to win a lawsuit.

The Appeal court found that every case has its own peculiarity and requires special factors. Nonetheless, almost all the circuit courts use their "standard" test (which vary among circuits). Any additional factors requires additional burden to moving party "why there is a need for additional factor(s)." In fact a party has to overcome this threshold before the actual analysis of confusingly similar starts. This threshold cuts against the "fair play." The trademark law originally was a state law and only later on, to provide a uniform law, the congress enacted the Lanhan Act. However, every circuit court recognizes a different "standard" test for the factors[17] is the corner–piece of this dispute; the standard factors which determine the confusingly similar test. Since, the trademark went through transformation from a state law, to a federal law the main test in the trademark act should also follow the transformation and become a national standard.

The creation of different standard test by the different Circuit courts are not cosmetic. There are many situation in which one case if will be analyzed by the ninth circuit standard test will be determined non-infringing while in the eighth circuit will consider as infringing. For example, for the present case even with the modified facts excluding the hersey testimony: Factor (3) The respondent advertised for a long time that the respondent

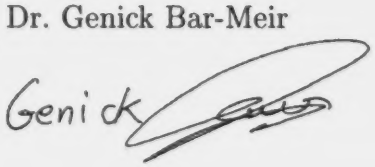
[17]It has to be said that some elements of the test are widely accepted as a national standard. For example, the trademark are separate into 4 categories of strength, 1)arbitrary or fanciful marks; (2)suggestive marks; (3)descriptive marks; and (4)generic marks. However, there is minor discrepancy between what is border between the suggestive mark to the descriptive mark.

is not nadca.org[18]. clearly favor the petitioner. Factor (5) the petitioner use the mark only on the Internet where most people never hear about North American Die Casting Association. Thus how community learned from the respondent that the respondent is not associated nadca.[org,com,net]. And when one looks for nadca.com find totally different organization. Factor (6) respondent conceded that "nadca" mark is recognized on the Internet the channel of distribution. Factor (7) clearly favor the petitioner since there more than one "NADCA" on the Internet. In this case, at the very least, the number of factors that against and for are even. However, if the actual confusion and the parody factors will be added, the petitioner's use of the mark is clearly not confusing anyone. This conclusion isn't surprising since in really no one confused in this small field of die casting. In fact, the particularly of the die casting field which is only a few thousands individuals. In the die casting field every one know what is going on and therefor cannot be confusion. This factor was supposed to be the dominated factor in this test but it simply was ignored.

Conclusion

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Dr. Genick Bar-Meir



DATE: May 18, 2002

Genick Bar-Meir, Ph.D.
1107 16th Ave S.E.
Minneapolis, Minnesota 55414-2411

[18]The respondent never contest that the responded actively advertised long before the petitioner choose the name nadca.org.

APPENDIXES

a1

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Civil No. 00-1666(RHK/SRN)

Genick Bar-Meir
Plaintiff,

v.

NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .

ORDER

Defendant's Motion for Summary Judgment is referred to Magistrate Judge Susan Richard Nelson for a recommended disposition. JUdge Nelson will hear Oral arguments on said Motion at 1:30 p.m. on Friday, February 23, 2001 in St. Paul, Minnesota. The 8:00 a.m. hearing before the undersigned on February 23, 2001 is CANCELD.

Dated: February 15, 2001

/S /
RICHARD H. KYLE
United States Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .

Civil No. 00-1666(RHK/SRN)

ORDER

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION, EDMUND A. HERMAN, ANDREW BEHLER, WILLIAM WALKINGTON, JOHN WRONOWICZ, DAINEL TWAROG, and STEVE UDVARDY,
defendants.

Civil No. 00-1737(RHK/SRN)

Plaintiff Genick Bar-Meir appeared pro se.

Debra Stanek, Esq., (via telephone), and Dean Eyler, Esq., on behalf of Defendant North American Die Casting Association.

FILED MAR 27 2001
FRANCIS E. DOSAL, CLERK
JUDGMENT ENTD _____
DEPUTY CLERK _____

SUSAN RICHARD NELSON, United States Magistrate Judge

The above-entitled matters come before the undersigned Magistrate Judge of the District Court on February 23, 2001, on several of motions. Each is discussed separately below.

A. **Defendant's Motion to Compel Responses to Interrogatories and Document requests in Civil File No. 00-1737(RHK/SRN)**

...

B. **Plaintiff's Motion to Obtain Permission to Amend/Supplement the Complaint in Civil No. 00-1737 (RHK/SRN)**

...

C. **Defendant's Motion for Entry of Protective Order Protecting Confidentiality of Discovery Material in Civil No. 00-1666 and 001737 (RHK/SRN)**

Pursuant to Fed. R. Civ. P. 26(c), Defendant NADCA moves, in both of the above-captioned cases, for entry of a Protective Order intended to: 1) protect confidential information produced in discovery; 2) limit use of discovery materials to the preparation and trial of this action; and 3) protect third parties connected with NADCA from annoyance, embarrassment, oppression, and undue burden and expense.

Following the the Court's suggestion made during the November 30, 2000 pretrial scheduling conference, NADCA submits that it forwarded to Plaintiff a draft protective order (in the form attached to this motion) which permitted either party to designate as confidential material that it believes contains commercially sensitive, proprietary, or trade secret information. The draft order also limited the use of material produced in the discovery process solely to the preparation and trial of these actions. Finally, the draft order limited Plaintiff's ability to contact third

parties who are members of NADCA or NADCA's Board of Governors except through discovery methods under the Federal Rules of Civil Procedure and approved in advance by the Court. Plaintiff has declined to sign NADCA's proposed protective order.

The Court grants in part and denies in part NADCA's motion for entry of a protective order governing production and use of documents and information. To this end, the Protective Order attached as Exhibit A hereto shall be in effect for all aspects of both of both the above-captioned cases. Defendant NADCA's motion for entry of its proposed protective order is denied, but the protective order set forth at Exhibit A attached hereto shall govern the proceedings in both of the above-captained cases.

D. **Defendant NADCA's Motion for Entry of a Protective Regarding the Depositions of Andrew Behler and Daniel Twarog in Civil No. 00-1737 (RHK/SRN)**

. . .

E. **Plaintiff's Motion to Impose Costs of Service on Defendant in Civil Case no. 00-1666 (RHK/SRN)**

Plaintiff moves for an order imposing the costs of personal service of the Complaint on Defendant NADCA because he believes that since he followed the law to the letter, he should recover his full costs of service. Plaintiff brings his motion pursuant to Fed.R.Civ. P. 4(d)(2). Plaintiff asserts that he sent the Complaint via first class mail to Defendant along with a request fro a waiver of services of summons. Plaintiff now seeks reimbursement of "coss" of such service in the amount of $764.50.

Defendant NADCA opposes this motion, contending it is not proper to require NADCA to pay Plaintiff's inflated costs of service because NADCA did not receive the Complaint until after Mr. Twarog was personally served, nor did NADCA receive any Notice of Lawsuit and Request for Waiver of Service of Summons forms. See Declarations of Daniel L. Twarog and Ruth Parat.

NADCA contends, as an initial matter, that Plaintiff has not made a proper showing that he has complied with all the requirements of Fed. R.Civ.P. 4(d)(2), especially as to the explicit requirement in Paragraph 2(A) that "a request for waiver of service by a corporate defendant must be addressed to a person qualified to receive service." Fed. R. Civ. p. 4, Advisory Committee Notes to 1993 Amendments. To be sure, Fed. R. Civ. P. 4(d)(2)(A) requires that, where the defendant is not an individual, the notice and request for waiver of service "shall be addressed ... to an officer or managing or general agent (or other agent authorized by appointment or law to receive service of process." Defendant NADCA correctly points out that Plaintiff Bar-Meir has made no showing that he complied with this requirement.

Finally, NADCA correctly asserts that effective service of the Complaint was not accomplished when Plaintiff copied NADCA's counsel on an e-mail message that purported to include the text of the Complaint.

The Court denies Plaintiff's motion to impose costs of personal service of the Complaint on NADCA. Plaintiff has simply not shown that he complied with all of the requirements of the Fed.R.Civ. P. 4(d)(2), and his "pro se status does not excuse non-compliance with the service requirements under Rule 4." See Rockett v. Marten Transport, Ltd. 2000 WL 816785, *2 (N.D. Ill 2000). Plaintiff's motion to impose costs of service on NADCA is denied.

F. Defendant NADCA's Motion for Entry of a Protective Regarding the Depositions of Andrew Behler and Daniel Twarog in Civil No. 00-1666 (RHK/SRN)

Plaintiff Bar-Meir moves for an order compelling Defendant NADCA to to answer outstanding interrogatories and produce documents responsive to pending requests for production of documents. Plaintiff contends that NADCA has improperly claimed that some of the information he has requested in discovery is either irrelevant, burdensome, or confidential. Plaintiff seeks an award of his costs and fees associated with bringing this motion.

In opposition to this motion, NADCA represents that it timely served its responses to Plaintiff's November 2, 2000 interrogatories, document requests and requests for admission. NADCA submits that in a letter dated December 13, 2000, Plaintiff took issue with NADCA's responses to Interrogatories Nos. IV, V, and VI and Document Requests Nos. II, IV, V, and VII. NADCA states that it responded in writing. It is this response by NADCA, along with some additional interrogatories and document requests, that is the subject of Plaintiff's motion.

To begin, NADCA asserts that it has not wrongfully withheld certain confidential information. NADCA points out that among the documents Plaintiff has requested are those which support NADCA's counterclaim and affirmative defenses, among other things, and include, for example, its advertiser lists which are not public and are proprietary. NADCA represents that once a protective order is entered it will produce responsive confidential information.

The Court notes that a protective order is now in place, as discussed infra at Section C, and covers production of information in both of the above-captioned cases.

Plaintiff's motion to compel was extensively discussed during the motions hearing. Consequently, the Court's written ruling will contain only the briefest of discussion. Plaintiff's motion to compel is:

1) denied as moot as to Interrogatory No. 1 because NADCA supplemented it response to clarify Mr. Twarog role in response preparation, and NADCA need not disclose the names of consulting attorneys;

2) granted as to Interrogatory No.2 to the extent that NADCA needs to, within one week of the date of this Order, identify every complaint made with respect to the NADCA trademarks at issue in this lawsuit (Civ. No. 00-1666), and not limit its response to legal complaints;

3) denied as to Interrogatory Nos. 4 and 5 because discovery in this matter has been bifurcated and Plaintiff is not entitled to take discovery on the issue of damages until sometime after the

June 15, 2001 conclusion of liability discovery;

4) denied as to Documents Request No. 1 as NADCA represents it has produced all responsive information it has subject to well-founded and fully explained objections on the grounds of overbreadth, privilege, or damages issues – and NADCA will produce responsive confidential information under the auspices of the protective order now in plaice in these matters;

5) denied as to Documents Request No. 2 because NADCA has fully responded (subject to legitimate objections of overbreadth, privilege, or pertinence to damages issues), and represents it has produced all responsive documents in its possession, custody and control; and

6) denied as to Document Request No. 4. because it seeks damages information. Discovery in this matter has been bifurcated and Plaintiff is not entitled to take discovery on the issue of damages until sometime after the June 15, 2001 conclusion of liability discovery.

Based on the foregoing, and all the files, records and proceedings herein,

IT IS HEREBY ORDERED that:

1) Defendant's Motion to Compel Responses to Interrogatories and Document Requests (Doc. No 28 in Civil 00-1737 and Doc. No. 25 in Civil No. 00-1666) is GRANTED in its entirety. Plaintiff shall produce all responsive information within one week of the date of this Order. Defendant's request for an award of attorney's fees and costs incurred in connection with this motion is denied without prejudice;

2) Plaintiff's Motion to Obtain Permission to Amend/Supplement the Complaint in Civil No. 00-1737 (Doc. No. 22) is:

- **DENIED** with respect to Plaintiff's request for leave to amend his Complaint to include a claim that Defendant NADCA violated Section 1202(a)(1) of the Copyright Act;

- **DENIED** with respect to Plaintiff's proposed amendment relative to personal jurisdiction over the individual Defendants;

- **DENIED AS MOOT** with respect to Plaintiff's attempt to add Paul Bralower and William Butler as Defendants in this matter; and

- **DENIED** with respect to Plaintiff's attempt to add Walkington Engineering as a party Defendant;

3) Defendant's Motion for Entry of a Protective Order Protecting the Confidentiality of Discovery Materials (Doc. No. 25 in Civil No. 00-1666) is **GRANTED**;

4) Defendant's Motion for Entry of a Protective Order Protecting the Confidentiality of Discovery Materials (Doc. No. 28 in Civil No. 00-1737) is **DENIED IN PART AND GRANTED IN PART** as set forth fully in the body of this Order which contains the terms of the Protective Order which shall govern the proceedings in the above-captioned matters;

5) Defendant NADCA's Motion for Entry of a Protective Order Regarding the Depositions of Andrew Behler and Daniel Twarog (Doc. No. 28 in Civil No. 00-1737 and Doc. No. 25 in Civil No. 00-1666) is **DENIED AS MOOT IN PART AND GRANTED IN PART** as set forth in the body of this Order;

6) Plaintiff's Motion to Impose Costs of Service on Defendant (Doc. No. 20 in Civil No. 00-1666) is DENIED;

7) Plaintiff Motion to Compel Answer Questions and Production of Documents (Doc. No. 39 in Civil No. 00-1666) is:

- **DENIED AS** MOOT as to Interrogatory No. 1;

- **GRANTED** as to Interrogatory No. 2 to the extent that NADCA needs to identify every complaint made with respect to the NADCA trademarks at issue in this lawsuit (Civ No. 00-1666), and not limit its response to legal complaints, and NADCA shall provide Plaintiff with this information within one week of the date of this order;

- **DENIED** as to Interrogatory Nos. 4 and
- **DENIED** as to Document Request Nos. 1, 2 and 4, all as set forth in the body of this Order.

Dated: Mar 27, 2001.

/S /
Susan Richard Nelson
United States Magistrate Judge

EXHIBIT A

PROTECTIVE ORDER IN CIVIL CASE NOS. 00-1666 AND 00-1737

DESIGNATION AS CONFIDENTIAL

1. When a person (Producing Party) provides to a party (Discovering Party) material that Producing Party believes contains commercially sensitive, proprietary, or trade secret information, including by way of example, confidential research, development, commercial, personnel, or other business information, the Producing Party may designate the material as "Confidential." Material may be designated by marking the first page "Confidential." When a Producing Party who is not a party to this Order produces material received from a party to this Order, the party to this Order may designate the material as "Confidential" and shall be deemed a Producing Party with respect thereto.

2. A Producing Party may correct a designation by notifying in writing the persons to whom the material was provided.

OBJECTIONS TO CONFIDENTIALITY

3. A party may object to the designation of material by notifying the Producing Party in writing of its reasons therefor. The Producing Party shall, within 7 days after receiving such notice, respond in writing. A party objecting to a designation may

move the Court for an order that material is not "Confidential." Before filing such a motion, the parties shall confer in a good faith effort to resolve the dispute.

RESTRICTIONS ON USE OF MATERIAL

4. All material provided by a Producing Party, including Confidential material, may be used by a Discovering Party only in connection with the preparation and trial of this action and the Discovering Party may not, unless otherwise permitted by law, publish, reproduce, publicly display, or otherwise sue any material provided by a Producing Party.

5. Except as ordered by the Court, Confidential material may not be publicly disclosed and may be provided only to:

a. A party

b. Counsel for a party, their partners, associates, associate counsel, and regularly-employed office staff;

c. Subject to Paragraph 7, independent experts retained to provide in connection with the preparation and trail of this action;

d. A person whose testimony is taken (who is not otherwise permitted access to Confidential material) during his or her testimony only;

e. Court reporters and their staff; and

f. The Court and any person employed by the Court whose duties require access to the material.

6. A party shall not be precluded from showing any material, regardless of this designation, to a person identified therein as its author or recipient.

IDENTIFICATION OF EXPERTS

7. Prior to disclosure of Confidential material pursuant to paragraph 5(c) or 5(d), a party shall provide 7 days written notice to the Producing Party, identifying the person. If the Producing Party does not consent in writing to disclosure shall be made except by order of the Court. before seeking such Court order, the

parties shall confer in a good faith effort to resolve the dispute. If the Producing Party consents in writing to the disclosure, or if the Court orders the disclosure, the material may be disclosed in accordance with paragraph 9.

UNDERTAKING TO BE BOUND BY PROTECTIVE ORDER

8. Except as set forth in paragraph 10, before material is disclosed pursuant to paragraph 5(c) or 5(d), the person shall read a copy of this Order and evidence agreement to be bound by it by signing an Undertaking to be Bound, in the form attached as Exhibit A to NADCA's proposed Protective Order. A copy of this Order and signed Undertaking shall be retained for one year after the termination of the is action.

DEPOSITIONS

9. Portions of deposition transcripts may be designated Confidential during the deposition or within 15 days after receipt of the transcript. Prior to expiration of this 15-day period, the entire transcript shall be treated as Confidential. After expiration of the 15-day period, the transcript of the designated testimony shall be bound in a separate volume and appropriately marked. If a deposition transcript of exhibit contains Confidential material that cannot conveniently be segregated, a party may request that he entire transcript or exhibit be treated as Confidential.

USE IN COURT FILLINGS

11. If a party files with the Court material containing Confidential material, the filing party shall file the material in a sealed envelope, with a cover sheet identifying, the material as confidential and subject to a protective order.

USE AT HEARINGS OR TRIALS

12. If a party reasonably anticipates that it may disclose or offer into evidence at hearing or trial any material designated pursuant to this Order, if shall give two days notice to the Court and the other party as such disclosure or offer. Notice is satisfied by service of witness and exhibit lists. In the absence of such notice, prior to disclosing any designated material, counsel shall advise the Court and opposing counsel and shall request,or give the Producing Party the opportunity to request, that persons not authorized by this Order to receive such information be excluded.

RETURN OF CONFIDENTIAL MATERIAL

13. Within 30 days after termination of this action, a Producing Party any direct in writing that Confidential material provided by the Producing Party by returned or destroyed. The Producing Party shall bear the reasonable expense of its request for return. Within 30 days after receipt hereof, counsel shall return or destroy the material, as requested, including copies, notes and any other medium containing the material, except that counsel (a) destroy Confidential material stored electronically, and (b) retain work product memoranda, pleadings, or other materials that include Confidential material, provided that the material remains appropriately designated.

14. The terms of this Protective Order shall survive and remain in full force and effect after the termination of this action.

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .

Civ.No.00-1666(RHK/SRN)

ORDER

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION, Edmund A. Herman, Andrew Behler, William Walkington, John Wronowicz, Daniel Twarog, and Steve Udvardy,
defendants.

Civ.No.00-1737(RHK/SRN)

Plaintiff has appealed from the March 27 Order of Magistratge Judge Susan Richard Nelson in which she resolves several nondispositive motions that had been heard on February 23, 2001. Finding that the Order appealed from is neither clearly erroneous nor contrary to law, said Order (Doc No. 51 in CV-00-1666 an Doc. No. 59 in CV-00-1737) is AFFIRMED.

Dated: April 16, 2001

/S /
RICHARD H. KYLE
United States Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Genick Bar-Meir Civil No. 00-
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .
1666(RHK/SRN)

ORDER

Genick Bar-Meir Civil No. 00-
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .
1737(RHK/SRN)

Plaintiff Genick Bar-Meir appeared pro se.

Debra Stanek, Esq., (via telephone), and Dean Eyler, Esq., on behalf of Defendant North American Die Casting Association.

FILED MAY 11 2001
FRANCIS E. DOSAL, CLERK
JUDGMENT ENTD _____
DEPUTY CLERK _____

SUSAN RICHARD NELSON, United States Magistrate Judge

The above-entitled matters come before the undersigned Magistrate Judge of the District Court on April 5, 2001, on several of Plaintiff Bar-Meir's motions. Each is discussed separately below.

A. **Plaintiff's Motion for Order Compelling Responses to interrogatories and Document Request, and for Sanctions in Civil File No. No. 00-1737 (RHK/SRN)**

. . .

B. **Plaintiff's Motion to Obtain Permission to Amend the Complaint in Civil No. 00-1737 (RHK/SRN)**

. . .

C. **Plaintiff's Motion to Impose Costs and Sanctions for Providing Affidavits in Bad Faith in Civil Case No. 00-1666 (RHK/SRN)**

Plaintiff moves for an order imposing costs and sanctions on Defendant NADCA for NADCA's alleged provision of false declarations in support of its motion for summary judgment. Plaintiff contends that NADCA submitted these affidavits in bad faith, and requests that the affidavits be precluded, and that NADCA pay all costs incurred by Plaintiff as result of this motion.

NADCA opposes Plaintiff's motion apparently brought pursuant to Fed. R. Civ. P. 11. NADCA argues that Plaintiff has not complied with the requirements of Rule 11, and that his that his failure to comply provides an adequate basis for summary dismissal of this motion. See McNeil v. United States, 113 S.Ct. 1908, 1908, 1984 (1993) "[W]e have never suggested that procedural rules in ordinary civil litigation should be interpreted so as to excuse mistakes by those who proceed without counsel.") Nevertheless, NADCA has addressed the merits of Plaintiff's motion.

However, in light of this Court's recommendation that Civil File No. 1666 (SRN/RHK) be dismissed, (see Report and Recommendation dated May 11, 2001), the Court finds this motion to be not only moot but without merit. Accordingly, this motion is denied.

D. **Plaintiff's Motion to Postpone the Hearing on the Summary Judgment in Civil Case No. 00-1666 (RHK/SRN)**

Plaintiff Bar-Meir moved, on January 19, 2001 to postpone the hearing on Defendant NADCA's motion for summary judgment as well as the hearing on NADCA's motion to compel production of documents. In support of this motion, Plaintiff cited his concern that he would not have time enough to prepare responses to these motions. The Court notes that Defendant NADCA filed its initial Notice of Motion and Motion for Summary Judgment on January 10, 2001, setting it on for hearing February 7, 2001. See Docket Entry No. 26. NADCA filed a Revised Notice of Motion and Motion for Summary Judgment on January 26, 2001, setting it on for hearing on February 23, 2001. See Docket Entry No. 38. NADCA's Motion to Compel (Docket Entry No. 25) filed on December 28, 2000, was also set for hearing on February 23, 2001, (see Docket Entry No. 37).

The Court notes that Plaintiff had more than 30 days to prepare for the hearing on NADCA's Motion for Summary Judgment, and almost two months to prepare for the hearing on NADCA's motion to compel discovery production. There is no indication that this was an inadequate amount of time for Plaintiff to prepare his responses to these motions, and Plaintiff's motion for postponement of th hearing is denied.

Based on the foregoing, and all the files, records and proceedings herein,

IT IS HEREBY ORDERED that:

1) Plaintiff's Motion for an Order Compelling Responses to Interrogatories and Document Requests in Civil File No. 00-1737 (RHK/SRN) (Doc. No. 52) is **DENIED IN PART, DENIED AS MOOT IN PART, AND GRANTED IN PART** as set forth fully

in the body of this Order as Section A;

2) Plaintiff's Motion for an Order Awarding Sanctions in Civil File No. 00-1737 (RHK/SRN) is **DENIED**;

3) Plaintiff's Motion to Obtain Permission to Amend the Complaint in Civil No. 00-1737 (Doc. No. 57) is **GRANTED**. The Court submits for filing with this Order the original Third Amendment to the Complaint which Plaintiff provided to the Court on April 24, 2001. To the extent he has not already done so, Plaintiff is directed to serve Defendant NADCA with a copy of the Third Amendment to the Complaint in its complete from with the pertinent exhibits attached;

4)Plaintiff's Motion to Impose Costs and Sanctions for Providing Affidavits in Bad Faith in Civil Case No. 00-1666 (RHK/SRN) (Doc. No. 50) is **DENIED**; and

5) Plaintiff's Motion to Postpone the Hearing on Summary Judgment [and Defendant's Motion to Compel] (Doc. No. 33) is **DENIED**

Dated: May 11, 2001.

/S /
Susan Richard Nelson
United States Magistrate Judge

(At this time a brief recess was taken.)

THE COURT: All Right. we're back on the record now in the matter of Bar-Meir versus North American Die Casting, civil file 00-1666. We're here for plaintiff's motion to impose costs and for sanctions. Dr. Bar-Meir, would you like to proceed?

MR. BAR-MEIR: Yes. I submit this motion according to Rule 57(g), which is dealing with bad faith affidavit. I'm not sure that's exactly the correct number, but this is what I found ion the federal rule. I don't believe there is any local rule regarding to 57(g) or similar to that, so I assumed that the federal rule governed in this case. My Understanding that somebody want to prove that something that is false, you have to prove that something that everyone accept, if this false would be true, it would contradict something that somebody else said. If that's correct, it means something has to break, it doesn't hold.

So what, basically I'm trying to do, and I'm trying to do, and I'm showing here is that this guys, they have conflicting statement or they have something that is conflicting other thing.

THE COURT: This all has to do with the question of whether they were actually confused; is that right?

MR.BAR-MEIR: This have to do with tow of them in actual confusion and Mr. Twarog is - - there is two things, because the tried to play the two things – one he tried to play it with personal jurisdiction to say, look I don't contact with him; and then he try to say I'm bad guy and I have a lot of contact with him, and he put all my communication with him – I mean me, the plaintiff, put it on the – on my web site.

0.1 Introduction

Dr. Bar–Meir submits this memorandum, affidavits and exhibits in support of plaintiff's motion impose cost for providing affidavits in bad faiths. The defendant provided the affidavits in support of the defendant's motion for judgment summary. These documents where important and essential part of the defendant evidence and arguments to get judgment in the defendant favor. In fact the defendant dedicated whole (section 4 of his memorandum) section in regards to "actual confusion." Thus, these documents were provided and drafted carefully by the defendant's attorneys.

The defendant rely heavily on the testimonies of the three individuals to support defendant case by allegedly showing actual confusion. While all the statements are false, Mr. Walker and Mr. Allen false affidavits contradict other facts and therefore it is shown here that the affidavits were given in a bad faith.

To demonstrate that a statement is false, one need to prove that if it (the false statement) is true it will contradict other accepted facts which no one even contest and are reliable. Here, the plaintiff demonstrates that, based on the documents provided by the defendant, the alleged declarations are false and were provided in a bad faith.

0.2 Facts

0.2.1 Gary Walker

Mr. Walker alleged that sometime in late December 1999 or January 2000, he got a letter about educational program. Since Mr. Walker statement does not provide a specific date or a specific message therefore all the messages that were sent in the said duration are discussed here. Later it will be shown that all the messages that were sent in the said time cannot be the alleged confusing message and all the messages that ever have been sent ever are discussed.

The defendant does not contest and will not contest that that the plaintiff sent only two email messages and of course at the very very best two to Mr. Walker during the enter 1999 (and of course only 2 during December 1999). December's messages were dated December 5, 1999 and other one was after December 27, 1999. In January there were only one possible massage dated January 17, 2000 send to Mr. Walker . There was another message sent to a small number of people in January 19, 2000 which was not send to Mr. Walker. All the messages that were send to Mr. Walker after that day encountered software which bounced the messages back to the plaintiff (see Exhibit A). The bouncing software is indication that Mr. Walker is not only know who is Dr. Bar–Meir but also acted in a great length and details in response to Dr. Bar–Meir knowing exactly who is nadca.org after February 1, 2000.

In Mr. Walker declaration, he stated (see Defendant motion for Summary Judgment Walker declaration) that "I received an e-mail message that identified the sender as individuals at "nadca.org." The text of the message described an educational program relating to die casting." The massage does not describe what exactly Mr. Walker referred to as educational program. NONE of these messages that were sent to Mr. Twarog discuss or mentioned class or educational program.

The classes were offered for the first time only on February 18 and followed by the second letter on Feb 24, 2000 in which notice that the classes were closed. On the email letter from Mr. Walker to his crony Mr. Terry Allen (see Exhibit C in plaintiff's opposition memorandum on summary motion) dated Feb 28, 2000 it is stated "I can see how someone could be "tricked" into thinking this was a NADCA activity. Heck, I was fooled!" This letter leave not even a shadow of doubt that Mr. Walker was not confused by a message of February 17, 2000 but allegedly by earlier message(s). There were no messages between January 19, 2000 to February 17, 2000. Thus, it was established that the possibility that Mr. Walker was alleged confusion by the four massages of December 1999 and January 2000.

All the four messages that were transmitted during (late and early) December 1999 and January 2000 do not discuss class or

even mentioned the word of education. The massage on December 27, 1999 (shown in Exhibit J of the plaintiff reply memorandum on Summary Judgment case 1666) discuss Mr. Twarog and and was followed by angry reply by Mr. Walker. Clearly, that letter was not the confusing letter. The letter did not mentioned any educational material and Mr. Walker knew very well who is the sender. In fact, he reply to message with "appropriate" content knowing exactly to whom he was sending the letter. In that letter he demand that Dr. Bar–Meir will leave the die casting field.

On January 17, Another massage was send to Mr. Walker that was the replay to his letter dated January 4. The message also did not mentioned any educational material. Furthermore, the message discuss in great details Mr. Walker. In fact the entire message was addressed to Mr. Walker with his original letter dated January 4, 2001. Thus, the foregoing leave that the only possibility that the confusing message was none from the time specified by Mr. Walker but perhaps by the one dated December 5, 1999. The foregoing discussion leave no possibility that a letter from the later date is the confusing letter. Even we assume that he was mistakenly to referred to Early December (as oppose to his "confusion" with time, since he stated that it was late December or January). Thus, the only possibility that Mr. Walker alleged that he was confused by the message dated December 5, 1999.

Since the identify of the only possible "confusing" letter was established what is remain to prove that the content of said letter cannot prompt the alleged statement given by Mr. Walker. This fact is established by the following elements:

- The "confusing" letter never discuss the education or classes alleged by Mr. Walker. At the very most it discusses a free offer of a book.

- North American Die Casting Association never mentioned these "actual confusions" in the proceeding of WIPO. The defendant attorney who never missed any tiny technical details was not going to let this "nugget" escape if it was remotely the true.

- The "confusing" letter does not mimic any North American Die Casting Association letter since none exist.
- Supposed that North American Die Casting Association does broadcast eMail messages, the "confusing" message is so clear that in no way it can mimic any possible message from North American Die Casting Association. Here are the list of the elements why the letter cannot mimic.
  - The message referred to North American Die Casting Association "the letter address to Steve Udvardy from North American Die Casting Association";
  - The letter goes further and criticizes North American Die Casting Association.
  - The body contains long open letter (4 pages) to Steve Udvardy from North American Die Casting Association; and
  - The content is so critical of this organization that they describe it as inflammatory (see Mr. Allen comment on that letter put the exact statement, see also Mr. Twarog statement on that specific letter (see exhibit K from plaintiff Opposition to Summary Judgment).
  - The letter is signed by the plaintiff, Dr. Genick Bar-Meir.

Mr. Walker admits that he knows Dr. Bar-Meir past and present. Mr. Walker admits that he discuss with numerous individuals about Dr. Bar-meir before and during that relevant time. So how can individual who have such extensive knowledge of Dr. Bar-Meir offering a book get confused about and alleged that the letter was send from someone from "nadca.org" organization about educational class.

Mr. Walker alleged that the message he receive mimicked North American Die Casting Association messages. The plaintiff was member of North American Die Casting Association for about two years and never receive any email message about class or any other education offering from North American Die Casting Association(see attached affidavit). No one that is/was member of North American Die Casting Associationthat the plaintiff

know ever encounter eMail messaged from North American Die Casting Association in this regards. In fact, the defendant was requested in the interrogatory to provide such messages and the defendants claimed none exist.

The president of North American Die Casting Association, Mr. Walker does not need email messages. He must be aware of the all the classes. Furthermore, all the information about the classes is published in North American Die Casting Association magazine "Die Casting Eng." Furthermore, North American Die Casting Associationsend a hard copy of the classes the defendant offers. So how one get confused by eMail when he is used to receive a hard copy and he is the PRESIDENT of the sender.

Mr. Walker do not alleged that he was confused by a free offered of a book but education material. In § 4 Mr. Walker states "... asking them to consider sending some of our newly-hired engineers to the program that was described in the message." Later, Mr. Walker describe how great relieve he felt that he has found that the class are not from North American Die Casting Association and stop sending the employees. Clearly, Mr. Walker is referring to class and not to the book. Yet, even we assumed that Mr. Walker receive the message from February 18, 2000 somehow[19] somehow earlier, Mr. Walker must have notice the first paragraph state

> "Here is what the North American Die Casting Associationclaim "their teaching is almost as good as ours (check www.nadca.org/coverup.html)."
> YOU WILL BE JUDGE!
> Network Advance DIe Casting Assistance is proud to offer free classes to die casting engineers and die casting casting community in general. ..."

The second paragraph state Dr. Bar-Meir name in promenade location. Bare in mind that Mr. Walker prior to the confusion letter (just a few weeks) received the open letter addressed to him from Dr. Bar-Meir (see exhibit ?). Can a person who just

[19] perhaps Mr. Walker have secret way to get messaged even before they have been written.

received such open letter not being aware who is Dr. Bar–Meir from Network Advance Die Casting Assistance? Of course, he knew who is Dr. Bar–Meir.

0.2.2 Allen

Mr. Terrence J. Allen, alleged that one of the plaintiff's messages in late 1999. Mr. Allen claims he received an email message from "genick@nadca.org" offering a free book. Mr. Allen alleged that he then forwarded the message to his engineer, Randy Ryder, who would then decide if the book was of any use to Mr. Allen's business. The complaint seems to come when Mr. Allen claims he "...would have never done so if he had realized that the message was not from the North American Die Casting Association."

Here a discussion presented how Mr. Allen statements are conflicting with the internal email and email sent to the plaintiff. The defendant does not and should not contest the information the defendant provided on the behalf of Mr. Allen. The information was selected by the defendant attorney carefully so that it will not include "bad information." Even though, the plaintiff sure that messages provide by the defendant were altered to suit the defendant position. It is clear that the "laundry" done to the email messages was not enough.

Mr. Allen's Engineer, Mr. Randy Ryder, was instructed by Mr. Allen to send a letter to plaintiff because of Mr. Allen's alleged confusion. Yet when the said letter was sent, it was not addressed to "nadca.org" but the letter was addressed to "ifi@dieperfect.com" (see Exhibit W for the opposition summary judgment in this case). The web site "dieperfect.com" was the plaintiff old web site which was abandoned when the web provider refused to allow the plaintiff to pose certain information and to carry other operations. The web site was frozen during the whole year 1999 and most 1998. Yet, Mr. Allen confusion was so great that he has asked his engineer to send the letter to "dieperfect.com" instead of sending it to "nadca.org." Probably, his frequent visits to "dieperfect.com" got him confused. Nevertheless, the domain name "dieperfect.com" never mentioned the plaintiff's communication with any one in the last two years (1999,

2000). Hence, Mr. Allen must remember "dieperfect.com" not from any source that can be associated with the plaintiff. Thus, the question remains how he got the name?

The email itself don't contain an eMail address beside the sender email. The return email address (or the sender address) was genick@bullwinkle.itasca.net. So, how Mr. Allen knew about ifi@dieperfect.com. It must be from his extensive knowledge about the plaintiff, Dr. Bar–Meir. Mr. Allen remembered the letters he received from Dr. Bar–Meir in 1996. These debris, as Mr. Allen call them, means that he well award about the Dr. Bar–Meir. If he was looking for these "debris" from 1996, 1997 and earlier it must that he has a file on Dr. Bar–Meir. This fact establish that Mr. Allen did not ask his engineer, Randy Ryder to check the book but because the confusion but out of curiosity and he was fully aware who is Dr. Bar–Meir.

As this not enough, Mr. Allen in his letter to Twarog dated December 9, 1999 he stated "I've had one or two diatribes from him in the past, but never so targeted at NADCA, and individuals within NADCA." This letter can be interpreted only as he know very well who is Dr. Bar-Meir. Furthermore, he consider the letter Dr. Bar–Meir to be inflammatory toward to North American Die Casting Association. If the letter really mimic non existing alleged "broadcasting" letters by North American Die Casting Association than clearly it will not be "targeted at NADCA, individuals within NADCA." Any individual that believe that the letter was from North American Die Casting Association will not thing that letter is so negative toward North American Die Casting Association. These statements are contradiction!

In exchange of letters with his crony Mr. Walker [of course, the defendant "lost/erased" all the correspondence with the exception of the letter from February 28, 2000 (see Exhibit C in plaintiff's opposition memorandum on summary motion)]. Since the Court deny the Order to preserve documents, these documents are assumed here for now to be "lost." The defendant in the discovery alleged that non of the correspondence exist. Be it as it may. In the said letter the "second" confusion "occurred." In that confusion shortly about the message related to educa-

tional classes. Note that the letter was shortly after February 18 announcement of the classes and February 24 the announcement of "class is full." Mr. Walker confusion occur after January it must be that Mr. Allen's confusion was some time in February 2000. Then in this case the confusion was not about the book but about class material since the message dealt with class. However, Mr. Allen alleged that his confusion occurred due to or with respect to the book message. Therefor, Mr. Allen affidavit from this point view also conflict with the said letter.

Mr. Allen not only sent his engineer to check the book, he himself willingly and enthusiastically went to the plaintiff web site to download the book. This fact is demonstrated by his corresponds with Mr. Twarog. Here what he wrote on December 9, 1999 "I've tried to open his "book" which I downloaded from his "NADCA.org" web site, but apparently lack the proper program." First that he was aware that "nadca.org" belong to Dr. Bar–Meir. Second, and more importantly, if he really felt that it waste of time to check the book why in the world he went go to download the book himself? He download the book himself because he felt the book is important and not because the book was offered by North American Die Casting Association but because the book is written by Dr. Bar–Meir. Yet, Mr. Allen stated that he has not done so (asked his engineer to download the book) if he know that book was offered the "impostor" Dr. Bar–Meir. These statements are in clear contradiction and obviously one is false. At the very least the eMail messages are assumed to be true (at least from the defendant point of view) than the statement of Mr. Allen is false.

As someone who was involved in North American Die Casting Association from it conception as Mr. Allen was and further being in high position such as Board of Governors, Mr. Allen must be ware that North American Die Casting Association never offer anything for free. Mr. Allen must be aware that North American Die Casting Association always try to "squeeze" money from the its members and other die casting companies. Furthermore, he must be aware that North American Die Casting Association never has been offered a valuable book as the plaintiff's book for free. Yet, Mr. Allen seeing a letter signed by Dr. Bar–Meir offer free book immediately assumed that it was from North

American Die Casting Association which he was so involve and no one has told him about it. This contradiction is another demonstration of the false statement by Mr. Allen.

0.3 Daniel Twarog

Daniel Twarog's affidavit is full of false statements. While some statements can be argued to be "he said she said" other statements are contradict established facts.

An example of the first kind is his statement in §12 alleging that he told the plaintiff about the legal issue concerning trademark of North American Die Casting Association in NADCA. All the eMail messages that follow prove that such statement is false. Yet, the plaintiff recognizes the higher standard required from him and puts this issue aside.

Nevertheless, there are two statements that easily can be demonstrated to be false. In § 16 Mr. Twarog is trying to make a point that he was aware only in March or April 2000 about the eMail messages that the plaintiff was sending and thus initial the legal action only than. This point was important to this argument that the plaintiff is trying to portray himself as North American Die Casting Association. Yet, it is clear from his email to plaintiff dated January 4, 2000 already stating that he received plaintiff's letter from December 28.,1999. Clearly, Mr. Twarog statement is false. Furthermore, Mr. wrote this crony Mr. Allen on December 10, 1999 admitting to receive Dr. Bar–Meir letter Dated December 5, 1999 (see attached exhibit).

In statement § 14 Mr. Twarog alleged that the plaintiff published Mr. Twarog's letter on his web site prior to December 9,1999. Yet, to prove that the Mr. Twarog does have a limit contact with Minnesota Mr. Twarog provided affidavit in the case 1737. In the said affidavit he alleged that "My communications with the plaintiff have been very limited. In early December, 1999 he telephoned me at my NADCA office in Rosemont, Illinois. I believe that I returned his call on December 9, 1999. ... Except for these communications, I have never communicated

with Dr. Bar–Meir." Now Mr. Twarog alleged that the plaintiff has published the extensive communication with him on the web. Clearly, one of the two is at the very least was given to mislead the Court.

0.4 Argument

To prove that the statements are false the plaintiff need to prove that more likely than not the statement was made knowingly and intentionally is false. The standard is not require to prove beyond any shadow of doubt. The Rules states that the standard to be "to the satisfaction of the Court." Thus, the Court should stand in the shoes of the individuals who provide the affidavits and examine if the statements should make any sense and contradicts other facts. The forgoing discussion demonstrates that both individuals Mr. Walker and Mr. Allen gave false statements. There no doubts that defendant know very well that the statements are false.

Even the eMail letters between two individuals was not exist and the two individuals were confused from the same message dated December 5, 1999, there statement are false. The messages was signed by Dr. Bar-Meir and was extremely (it is mild statement) critical of North American Die Casting Association. Moreover, Mr. Walker and Mr. Allen are "confused" from the very same message, one by a free book and one by free class (educational material). There where not a single message that discuss these offerers in the said period of time. Clearly, Mr. Walker and Mr. Allen provided false statements. Or, at the very least one has provided false statement.

Nonetheless, the defendant attorneys are the one who drafted the affidavits as can be seem from the similar layouts. All the declamations were made using Roman font. All the declamations were made using ragged right format. All the declamations were made using the legal jargon. All the declamations the title referred to "Judge Richard H. Kyle/Magistrate Judge Susan Richard Nelson." Even if the defendant will alleged that defendant did not draft these messages, the defendant must be fully

aware of the contains and how these statements are false.

Mr. Walker stated before the complaint to WIPO "We should try to wrestle the domain name away from him. Clearly a copyright issue." Yet when the defendant filed a complaint with WIPO no even single time the "actual confusion" was mentioned. Obviously that experienced attorney like Ms. Stank does not missed this legal "nugget." This nugget was fabricated by the defendant and probably by its attorneys or at the very least must be awarded by them.

Further, the defendant must be aware to the credibility of Mr. Walker. Examination is done Mr. Walker credibility can be done by compering two of his messages. Walker's letter (see plaintiff opposition Memorandum Exhibit J) he tell the plaintiff nobody care about the plaintiff's work (see plaintiff opposition Memorandum Exhibit C). Yet, when he learn that one of his engineer is attending the plaintiff's class, he states "I will put the plug if someone use Bar–Meir's class." Clearly, the defendant attorneys must be aware to this information and of course other information such as not using these "actual confusion" in WIPO proceeding.

The Court must ensure that the sanction is tailored to address the harm identified. "Republic of the Philippines v. Westinghouse Elec. Corp., 43 F.3d 65, 73 (3d Cir. 1995). In this case the affidavits were the main point of the motion for summary judgment of the defendant. The plaintiff ask the Court to preclude the affidavits and to impose sanctions and cost on the defendant and their attorneys.

0.5 conclusion

In light of the forgoing discussion and the overwhelming evidence, the plaintiff's motion should be granted. Allow reasonable cost to the plaintiff and impose sanctions on the defendant and its attorneys and preclude the affidavit.

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Civ.No.00-1666(RHK/SRN)

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant.

Amended Report and Recommendation

The above entitled matter came before the undersigned United States Magistrate Judge on February 23, 2001, on Defendants' Motion for Summary Judgment on the Counterclaim and Complaint. (Doc. No. 26.) This motion has been referred to the undersigned pursuant to 28 U.S.C. § 636 and Local Rule 72.1.

For the reasons set forth below, this Court recommends that Defendant's Motion for Summary Judgment on the Complaint and Counterclaim be granted.

I. BACKGROUND

Defendant, North American Die Casting Association ("NADCA") is a not-for-profit technical and trade association for the die casting industry. (Twarog Decl., Doc. No. 30, ¶ 2.) Die casting is manufacturing process for creating metal parts that are used as components in consumer, commercial, and industrial products. (id ¶ 3) With 308 corporate members and more than 3,400 individual members worldwide, NADCA is the only trade association in the United States that represents die casters and die cast suppliers. (id ¶ 4) NADCA seeks to meet the technological and educational needs of the die cast industry by sponsoring research programs, compiling business statistics,

publishing technical and management materials, tracking federal policy issues, and expanding the markets for die castings. (id ¶ 5) NADCA operates an Internet website at www.diecasting.org. (id ¶ 6) The website provides information on the die casting association, advertising, and other general die casting information. (id) NADCA uses broadcast emails to alert its members of upcoming conferences, courses, registration reminders, publication release notices, and legislative alerts. (id ¶ 10.)

The trade name NADCA has been used by North American Die Casting Association since its inception in 1989. (Id ¶ 9) The die casting association owns two federal trademark registrations, one for the mark NADCA and another for NADCA logo. (Id.) NADCA has been successful in preventing the unauthorized use of its marks by others in the die casting industry. (Id ¶ 10.)

Plaintiff Genick Bar-Meir is a die cast engineer, and claims to be "the most widely known scientist by far in the area of die casting." (Compl. ¶ 5) Plaintiff was a member of NADCA and has, in the past, submitted and published articles in NADCA's trade publications. (Twarog Decl., Doc. NO 30, ¶ 11; Compl. Ex 28) Plaintiff also submitted his research to Defendant and made repeated requests for research grant. (Mem. in Opp., Doc. No 42, Ex. X.) Plaintiff wrote a book on the die casting process entitled The fundamentals of Die Casting Design and submitted his work for Defendant's review. (Mem. in Opp., Doc. No. 42 Ex. T.) Defendant disagreed with Plaintiff's findings and concluded that the Plaintiff extends his theories beyond practical die cast parameters and extends his calculations to decimal places that are unrealistically controllable in a modern die cast facility. (Mem. in Opp., Doc. No. 42 Ex. L.)

After Plaintiff was unable to make his scientific advances available to the die casting community through NADCA, Plaintiff registered the domain name www.nadca.org. for the purpose of "making the die casting industry profitable via inserting [sic] science and technology." (Mem. in Opp., Doc. No 42 Exs. P, T.) Plaintiff's "NADCA" stands for "Network Advance Die Casting Assistance." (Mem. in Opp., No 42, P. 31) On his website, Plaintiff offers free on-line die casting classes, advertises his book, The Fundamentals of Die Casting, and offers offers free advertis-

ing. (Pl.'s Ex. T; Coutercl., Ex. E.)

Plaintiff asserts that his material is "superior" and believes that only his methods of die casting are correct. (Answer to Countercl., Doc. No. 6, ¶ 7) Plaintiff believes that Defendant is inappropriately teaching erroneous material that violates the laws of physics and sponsoring erroneous research in the field of die casting. (Mem. in Opp., Doc. No. 42, Exs. J.Q.) According to Plaintiff, his website "nadca.org" serves as an outlet to show what is truly going on in the die cast industry. (Answer to Countercl., Doc. No. 6, ¶ 7.) Plaintiff contends that Defendant was not interested in this web site until it became "famous," after which, Defendant allegedly harassed Plaintiff's web provider by requesting that he close the website. (Compl. ¶ 10.) Plaintiff asserts that Defendant further harassed his in writing by asking him to leave the field of die casting and by writing a letter to Mark Yodof. (Compt. ¶).

After starting his website, Plaintiff contacted existing NADCA members through broadcast emails and set messages such as the following:

> "Hi,
>
> We would like you to know that you have an opportunity [sic] put a free ad on the Die Casting Bulletin Board. You need only to supply the html files and if you would like you can put small graphical files [sic]. We reserve the right to refuse/edit the ads. For your information, we have [sic] average of 50 visitors a day.
>
> For more information contact
> genick@nadca.org
> www.nadca.org
> "

(Countercl., Ex. D; see also Skoff Decl., Doc. NO. 29; Allen Decl., Doc. NO. 28; Walker Decl. Doc. NO 31) Jerald Skoff, an advertiser on Defendant's actual website, www.diecasting.org, believed that NADCA had an additional website. (Id.) It wasn't until Mr. Skoff contacted NADCA President, Daniel

Twarog, over concern that his advertising material might be edited, that he learned that Defendant NADCA did not run the www.nadca.org site. (Skoff Decl., Doc. NO. 29, ¶6) Another advertiser, Terence Allen, also believed that Plaintiff's email messages were from NADCA. (Allen Decl., Doc. NO. 28, ¶ 3) Because of this belief, Mr. Allen forwarded a message from Plaintiff to one of his employees. (Id. ¶ 5.) Mr. Allen testified that he would not have forwarded the email message had he known that the message was not from Defendant NADCA. (Id., ¶). Similarly, Gary Walker, a NADCA member, also received broadcast emails from "nadca.org" (Walker Decl., Doc No. 31.) In late 1999, Mr. Walker received an email form "nadca.org" offering educational programs relating to die casting. (Id ¶ 3.) Because Mr. Walker has used and been happy with NADCA's training programs in the past, he forwarded the message to engineers and scientists at his company asking them to consider sending newly hired engineers to the programs. (Id,. ¶ 5) According to Mr. Allen, the "nadca.org" email messages mimicked the broadcast emails that NADCA sends to its members. (Id.)

In April 2000, NADCA initiated an arbitration proceeding challenging Plaintiff's registration and use of "nadca.org" as his domain name with the World Intellectual Property Organization ("WIPO") Arbitration and Mediation Center pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") Adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN").[1] (Twarog Decl., Doc. No. 30. ¶r 18; Exs. A. B. to Answer and Countercl.) Defendant challenged Plain-

[1]In 1999, ICANN was recognized by the U.S. Department of Commerce as the nonprofit corporation responsible for governing the Internet. ICANN oversees the Internet's infrastructure, ensures competition among domain name registrars, helps to establish domain name dispute resolution policies, and determines whether and when to add new domain name suffixes. Lockheed Martin Corp. v. Network Solutions, Inc,. 2001 WL 460874, 2 (N.D. Tex.). ICANN and the U.S. Department of Commerce authorize WIPO to act as domain name registrar and arbitrator of cases involving Internet domain name disputes. PACAR, Inc, v. TeleScan Techs, L.L.C,. 115 F.Supp.2d 772 n.4 (E.D. Mich. 2000). The UDRP provides for resolution of domain name disputes through mandatory administrative proceedings. Domain name registrants must agree to abide by the UDRP, which permits the owner of a trademark to initiate and administrative complaint against an alleged cybersquatter. Lockheed Martin, 2001 WL 460874, at 2-3.

tiff's registration of "nadca.org" and sought to prevent Plaintiff from using "nadca.org" in a manner that was deceptive, misleading, or confusing. (Ex. B to Answer and Countercl.) Under the UDRP, Defendant was required to show (1) that the domain name was identical or confusingly similar to a mark in which NADCA has rights, (2) that Plaintiff had no rights or legitimate interests in the domain name, and (3) that the domain name was registered and was being used in bad faith. (Id.) The WIPO arbitrator determined that Plaintiff's use of "nadca.org" was identical to NADCA's registered trademarks, that Plaintiff had no legitimate interest in the domain name, and that Plaintiff's use of the domain name clearly fit within the definition of bad faith. (Id. The arbitrator ordered the domain name be transferred to Defendant.[2]

The domain name was not transferred because Plaintiff filed this lawsuit within ten days of the WIPO decision. Plaintiff seeks the following relief: (1) that the Court declare that the domain name "nadca.org" belongs to Plaintiff. (Compl., Doc. NO. 1.) Defendant brought a counterclaim alleging federal trademark infringement under 15 U.S.C. § 1114, federal unfair competition under 15 U.S.C. § 1125 (d). (Countercl., Doc. No. 4)

II. STANDARD OF REVIEW

Neither the ICANN Policy nor its governing rules dictate to courts what weight should b given to a panel's decision. See Weber-Stephen Products CO. Armitage Hardware and Bldg,. Supply, Inc., 2000 WL 562470, 2-3 (N.D. Ill.) However, the ICANN Policy and its accompanying rules do contemplate proceedings in federal court. For example, and arbitration panel's determination that a a domain name should be transferred, will be implemented within ten days of issuance unless the domain name registrant has commenced a law suit against the complainant in a qualified jurisdiction. Lockheed Martin, 2001 WL 460874, at 2-3. If such a lawsuit has been filed, no further action will be taken unless a settlement has been reached, the lawsuit has been dismissed or the court has rendered a decision requiring discontinuation of the registered domain name. Id.

[2]The original WIPO decision mistakenly ordered the domain name be transferred to "Respondent" (Plaintiff Bar-Meir). This typographical error was corrected to read "Complainant" (Defendant NADCA). Countercl., Exs. A.B.)

According to the Federal Rules of Civil Procedure, summary judgment is proper if there is no genuine issue of material fact and the moving party [sic] is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The moving party has the burden of showing the absence of a genuine issue of material fact and it is entitled to judgment as matter of law. Enterprise Bank v. Magna Bank of Missouri, 92 F.3d 743, 747 (8th Cir. 1996).

After motion for summary judgment is made and supported, it places an affirmative burden on the non-moving party to go beyond the pleadings and "by affidavit or otherwise" designate "specific facts showing that there is a genuine issue of trial." Robinson v. Monagham, 864 F.2d 6222, 624 (8th Cir. 1989); Buford v. Tremayne, 747 F.2d 445, 447 (8th Cir. 1984) (opposing party may not rest merely upon allegations of complaint, but must set forth specific facts showing genuine issue for trial); Fed.R.Civ.P. 56(e). "[T]he mere existence of some alleged factual dispute between the parties will not defeat tan otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-248, 106 S.Ct. 2505, 2510, 91 L.Ed. 2d 202 (1986). In determining which facts are material, courts look to the substantive law in a dispute and identify the facts with are critical to the out come. Id. A dispute about a material fact is genuine if the evidence is such that a reasonable trier of fact could return a decision in favor of the nonomoving party. Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586-87, 106 S.Ct. 1348, 1355-1356, 89 L. Ed.2d 538 (1986).

In performing the genuineness inquiry, court view the evidence and inferences which may be reasonably drawn from the evidence in the light most favorable to the nonmoving party. Adkison v. G.D. Searle & Co., 971 F.2d 132, 134 (8th Cir. 1992). A court is not "to weight the evidence and determine the truth of the matter but [instead should] determine whether there is genuine issue for trial." Anderson, at 249, 106 S.Ct. at 2511. When a party opposing summary judgment fails it burden, summary judgment "may and should be granted" if

the moving party otherwise satisfies the Rule 56(c) requirements. Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S. Ct. 2553, 91 E.Ed.2d 265 (1986).

III. ANALYSIS

A. Counterclaim Courts I & II: Trademark Infringement & Federal Unfair Competition

In Counts I and II of the Counterclaim, Defendant asserts claims under two sections of the Lanham Act, trademark infringement under Section 32, 15 U.S.C. §1114 and unfair competition under Section 43, 15 U.S¿C. § 1125(a).[3] Section 1114 prohibits the infringement of the a registered mark, while section 1125(a) does not require a registered mark but simply prohibits false designations or representations of a mark. Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc., 780 F.2d 1324, 1329 (8th Cir. 1985). Specifically, section 1114 prohibits the "use in commerce [of] any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of the goods or services on or in connection with with such use is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. 114(1)(a). Similarly, section 1125(a) prohibits the use, in commerce, of "any word, term, name, symbol, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. 1125(a)(1)(A).

To recover under either section 114 or 1125(a), an individual must show that he unauthorized use, of a protectable mark, in commerce is "likely to cause confusion." Home Builders Ass's of Greater St. Lauis v. L&L HehibitionManagement, Inc., 226 F.3d 944, 947

[3]The Lanham Act was intended to make "actionable the deceptive and misleading use of marks" and " to protect persons engaged in ... commerce against unfair competition." Section 45, 15 U.S.C. § 1127. Section 43(a) "prohibits a broader range of practices than does § 32," which applies only to registered marks. Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 858,102 S.Ct. 2182, 2190-2191, 72 L.Ed.2d 606 (1982).

(8th Cir. 2000) (Section 43 , 15 U.S.C. 1125(a)); Aanheuser-Busch, Inc. v. Balducci Publications, 28 F.2d 769, 773 (8th Cir. 1994) (Section 32, 15 U.S.C. 1114).

In determining whether a likelihood of confusion exists, courts take the following factors into consideration:

(1) the strength of the owner's mark;
(2) the similarity between the owner's mark and the alleged infringer's mark; (3) the degree to with thee products compete with each other;
(4) the alleged infringer's intent to pass off it goods as those of the trademark owner...;
(5) incidents of actual confusion; and
(6) the type of product, its cost and the conditions of purchase

SquirtCo v. Seve-Up Co. 628 F.2d 1086, 1091 (8th Cir. 1980). No single factor is dispositive. See Mutual of Omaha v. Novak, 836 F.2d 397, 399 n. 3 (8th Cir. 1987) ("These are not necessarily the only factors that might be relevant in a particular case. The ultimate inquiry always is whether , under all the circumstances, there exists a likelihood of confusion between the plaintiff's trademark and allegedly infringing use.").

1. Strength of the Mark

The Court first considers the strength of the mark. "Strong and distinctive trademark is entitled to greater protection than a weak or commonplace one." SquirtCo, 628 F.2d at 1091. Defendant argues that NADCA marks are strong because (1) Defendant owns two incontestable federal trademark registration for the mark NADCA and the NADCA logo, and (2) Defendant has extensively use the NADCA marks in marketing, advertising, and communications. (Def.'s Mot., Doc No. 27, p. 11.)

The relative strength of trademarks is evaluated according to four broad categories of mars which include, in descending order of strength, (1)arbitrary or fanciful marks; (2)suggestive marks; (3)descriptive marks; and (4)generic marks. General Mills, Inc. v. Kellogg Co., 824 F.2d 622,625 (8th Cir.

1987). An arbitrary or fanciful mark is "a word, either unknown or completely out of common usage , coined of the sole purpose of identifying products in the market place." Aveda Corp. v. Evita Marketing. Inc., 706 F. Supp. 1419, 1428 (D. Minn. 1989). Arbitrary marks are deemed the strongest "because their inherent novelty creates a substantial impact on the buyer's mind." Id. Suggestive marks subtly indicate something about the product, and require imagination, thought or perception to reach a conclusion concerning the nature of the goods. Northland Ins. Cos. v. Blaylog, 115 F. Supp. 2d 1108, 1118 (D. Minn. 2000). A descriptive mark conveys the characteristics, the qualities or other features of product but can bonly be protected in the mark has become distinctive by acquiring a secondary meaning. General Mills, 824 F.2d at 625. A generic term does not indicate the source of the product or service, but merely defines a type, genus or class of service, and is not entitle to any protection. Id.

Defendant has tow federally registered trademarks, one for the name NADCA another for the NADCA logo. (Twarog Decl. ¶ 9) The registration of a trademark is prima facie evidence of the mark's validity, the registered mark in commerce, 15 U.S.C. § 1115(a). Defendant asserts that its marks are strong because they have obtained "incontestable statue." Incontestable trademarks are ones which have been registered and have been in continuous use for five consecutive years obsequent to the date of registration. 15 U.S.C. § 1065. Subject to a number of defenses , and "incontestable" mark is "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115(b).

However, incontestability alone does not establish the strength of a mark. For example, a descriptive trademark, even if incontestable, may only be entitled to minimal protection because a company's trademark may be strong in one market but week in another. See Amstar Corp. v. Domino's Pizza, Inc., 615 F. 2d 252, 260 (5th Cir. 1980) ("Domino" mark is strong in sugar products but weak for other food products). Plaintiff argues that Defendant's mark is weak because "no ordinary per-

son would assume that checking the web for 'nadca' would refer that person to anything remotely associated with North American Die Casting Association." (Mem. In Opp., Doc. No. 42 , P 31.) As evidence of this fact, Plaintiff explains that other industries also use the acronym "NADCA," such as the National Air Duct Cleaner Association." (Id. However, the National Air Duct Cleaner Association is a wholly separate industry from the die casting [sic] industry and their products and information are marketed to fundamentally different purchasers. Unlike the National Air Duct Cleaner Association, Plaintiff uses the "NADCA" mark in the same market as Defendant and seeks to reach the same community of people, die casting [sic] professionals. Therefore, Plaintiff's use of "NADCA" is not merely a fair use of the mark to describe a non-die casting related product or service.

In the field of die casting "NADCA" is known to refer to Defendant North American Die Casting Association, therefor Defendant's mark is strong because it si more than merely "descriptive" in the field of die casting. There is only one trade association in the die casting, and that is the Defendant NADCA. Furthermore, Defendant has used this mark extensively since 1989 and is known by the NADCA mark in the field of die casting. (Skoff Decl., Doc. No. 29; Allen Decl., Doc. No. 28; Walker Decl., Doc., NO. 31) NADCA has also been successful in preventing the unauthorized use of its marks by others in the die casting industry. (Twarog, Decl. ¶ 10) See Board of Trustees of Univ. Ark. v. Professional Teraphy Servs., Inc., 873 F. Supp. 1280, 1285 (W.D. Ark 1995) (a court may consider the inherent distinctiveness of the mark, the long-term use of the mark by the owner, the extent of public exposure for the mark through advertising, promotion and unsolicited publicity, and the owner's actions to protect it marks).

The evidence clearly shows that Defendant's marks are neither generic nor merely descriptive in the field of die casting. Therefor , the first factor, the strength of the mark, favors Defendant.

2. Similarity Between Marks

Defendant contends that Plaintiff's use of "NADCA" and "nadca.org" are identical to Defendant's federally registered trademarks. Plaintiff admits that Defendant's mark "NADCA"

and his use of "nadca.org" are similar. (Mem. in Opp., Doc. No. 42, P. 31.) But, Plaintiff argues that he community of the die casting engineers is small and that this community of people already knows about his organization, the "Network Advance Die Casting Assistance," and therefore, Plaintiff argues, this factor should be considered neutral. (Id)

Plaintiff's reasoning does not explain how the marks are dissimilar. Defendant clearly use the Mark NADCA first and and Plaintiff's subsequent use, of the same mark, even if later associated with Plaintiff as well, does not mitigate against the fact that the marks are similar. Although Plaintiff uses the name NADCA , with association of ".org" as the domain name for his die casting website, courts have consistently held that the use of a registered mark is not abrogated by incorporation into a domain name. "The fact that defendant adds the ".com" to plaintiff's mark is relevant." Northland, 115 F.Supp.2d at 1119.

Defendant's mark "NADCA" and Plaintiff's use of "ndaca.org" are clearly similar. The second factor, similarity, favors Defendant.

3. **Degree of Competition Between Parties**

Defendant asserts that Plaintiff directly competes with NADCA. (Def.'s Mem., Doc. No. 27, p. 12.) Although persuasive, evidence of direct competition is not needed for a finding of infringement because confusion, not competition, is the touchstone of trademark infringement. Mutual of Omaha, 836 F.2d at 399. Where the products are closely related less similarity is necessary to support a finding of infringement. David Sherman Corp. v. Heublein. Inc., 340 F.2d 377, 380 (8th Cir. 1965).

Plaintiff argues that he is not in competition with Defendant because (1) he will allow Defendant to use his material, and (2) he has a desire to see Defendant flourish "if it will teach the correct material and advance the die casting industry." (Mem. in Opp., Doc. No. 42, p. 32.) However, Plaintiff believes that Defendant is teaching "erroneous material," and has created his website and offered his materials as an alternative to the Defendant's teachings. (Compl., Exs. E, P.) Despite Plaintiff's alleged good will towards Defendant, the evidence shows that his theories, teach-

ings, and website are competing with Defendant. For example, in a letter to NADCA President, Daniel Twarog, Plaintiff explained the following: "You claim that both of us are right. Please no not elute [sic] the die cast community that my scientific findings can coexist with North American Die Casting Association's teaching. Let me make it crystal clear. There is no possibility for B to say that both A and B are right when A says that B is wrong; only one can be right." (Mem. in Opp., Doc. No. 42, Ex. T.)

Plaintiff asserts that there is no competition because his products are offered at no charge. (Mem. in Opp., Doc. No. 42, p. 26, 34.) Plaintiff confuses financial use with commercial use.[4] Although Plaintiff may not receive a direct financial benefit from using Defendant's mark, he is attempting to garner a commercial benefit by convincing the die casting [sic] industry that his die casting [sic] theories are superior to those of Defendant. (Mem. in Opp. Doc. No. 42, Ex. P, X (criticizing NADCA's choice of grant recipients and questioning why he was turned down for research grant funds)). Plaintiff is improperly receiving a benefit form the goodwill that Defendant has developed in its mark. In this case, each party seeks to capture the audience of die cast engineers, each seeks to explain current die cast theories through the use of classes and written material. Both parties have similar objectives, to serve the die casting community. (Bar-Meir Aff., Doc. No. 43, Ex. T; Twarog Decl. ¶ 2.) Both parties offer training courses and materials related to die casting. (Compl., Ex. 20; Bar-Meir Aff., Doc. No. 43, Ex. T; Twarog Decl. ¶ 5.) The evidence suggests a close competitive proximity between the Plaintiff's and Defendant's classes, products, and information, all of which increase the opportunity for confusion by consumers. The third factor also favors Defendant.

4. **Intent to Pass Off Goods**

The fourth factor in determining likelihood of confusion is the infringer's intent to pass off his goods as those of the trademark owner. Intent on part of alleged trademark infringer to

[4]There is no personal profit requirement in § 1114 or in § 1125. Plaintiff's materials clearly relate to the advertisement and distribution of Plaintiff's book and course materials. The word "commerce" means all commerce which may lawfully be regulated by Congress. 15 U.S.C. § 1127.

pass off its goods as the product of another raises the likelihood of confusion, but presence or absence of intent to confuse is not critical to finding likelihood of confusion. 15 U.S.C.A. § 1114(1)(a); Aveda, 706 F.Supp. at 1429.

> "It is so easy for the honest businessman, who wishes to sell his goods upon their merits, to select from the entire material universe, which is before him, symbols, marks and coverings which by no possibility can cause confusion between his goods and those of competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them."

Id.

Plaintiff argues that the use of "nadca" as an acronym represents his organization, Network Advance Die Casting Assistance. (Mem. in Opp., Doc. No. 42, p. 31.) Despite this assertion, Plaintiff has offered no legitimate rationale for choosing a name that creates the same acronym as the only other die cast association in the nation. It could have been no surprise to Plaintiff that the name of his organization mimicked Defendant's trademark. Plaintiff himself was a member of NADCA and had published works in NADCA magazines. (Twarog Decl., ¶ 9.)

Plaintiff claims to be the most well known scientist in the field of die casting, and yet he never identified himself by his full name in his email correspondence. (Compl. ¶ 5; Countercl. Ex. D.) Rather, Plaintiff signed his email genick@nadca.org. Plaintiff argues that the names "Genick," "Bar-Meir," and "Genick Bar-Meir" are so unusual, that the address genick@nadca.org is unique and lessens any confusion. However, the alleged uniqueness of his name and his status as a well known scientist cut against using the domain name "nadca.org" (Compl. ¶ 5.) When asked at the February 23, 2001, hearing, why he choose "nadca.org" as his domain name, Plaintiff responded that he wanted to appear "like a group." The evidence shows that the "group" that Plaintiff wanted to appear like was Defendant, NADCA.

As a final matter, Plaintiff asserts that there can be no intent inferred because he has placed a disclaimer on his website. (Mem. in Opp., Doc. No. 42, pp.32-33.) Plaintiff's warning does not mitigate against his intent because he used Defendant's mark to draw individuals to the website to offer them competing views and products relating to die casting. See Green Products Co. v. Independence Corn By-Products Co., 992 F.Supp. 1070, 1078 (N.D. Iowa 1997) (discussing the likelihood of confusion involved when a party deceptively lures consumers to a website using another's mark).

The evidence shows that Plaintiff's use of the name "nadca.org" was done with an intent to confuse the die cast community.

5. **Incidents of Actual Confusion**

"While actual confusion is not essential to a finding of infringement, its existence is positive proof of the likelihood of confusion." Northland, 115 F.Supp. at 1121. Defendant offers the testimony of three NADCA members, Terence Allen, Gary Walker, and Jerald Skoff all of whom received Plaintiff's "nadca.org" emails and were confused. (Allen Decl., Doc. No. 28, Skoff Decl., Doc. No. 29, Walker Decl., Doc. No. 31.) Mr. Allen, received an email from Plaintiff advertising the book, The Fundamentals of Die Casting. (Allen Decl., Doc. No. 28, ¶ 3.) Mr. Allen believed this message was from NADCA and forwarded Plaintiff's message to his employees. (Allen Decl., Doc. No. 28, ¶ 5.) Similarly, Mr. Walker received an email message from Plaintiff offering an education program. (Walker Decl., Doc. No. 31, ¶ 3.) Having participated in NADCA programs in the past, Mr. Walker forwarded this message to his engineers for consideration because he believed the message was from Defendant NADCA. (Walker Decl., Doc. No. 31, ¶ 4.) Finally, Mr. Skoff received an email offering advertising on the "nadca.org" website, which reserved the right to edit the advertisements. (Skoff Decl., Doc. No. 29, ¶ 4.) Mr. Skoff, an existing NADCA advertiser, was so concerned about the content of the email that he interrupted his vacation and personally contacted NADCA President Daniel Twarog. (Skoff Decl., Doc. No. 29, ¶ 6.)

Plaintiff questions the validity of these affidavits and claims that they are "only a separate attempt to stretch the truth in another desperate futile attempt to earn the Court's favor." (Mem. in Opp., Doc. No. 42, p. 34.) But Plaintiff does not provide competing affidavits, or any credible evidence, to show that these men were not confused. Rather, Plaintiff argues that these men should not have been confused because they are intelligent, experienced, and have visited his website. (Mem. in Opp., Doc. No. 42, pp. 16-26.) These facts do not diminish the fact that these NADCA members were actually confused when they first received Plaintiff's email from "nadca.org."

There is definitive evidence of actual confusion in this case, therefore, the fifth factor also favors Defendant.

6. Conditions of Purchase

Finally, the Court considers such factors as the type of product involved, its costs, the conditions of purchase, and the degree of care to be exercised by potential customers in making their purchasing decision. SquirtCo., 628 F.2d at 1091. The products in this case are die casting [sic] educational classes and materials offered through email solicitation. The target of Plaintiff's emails and website is the die casting community; individuals who presumably have a high level of sophistication in the field of die casting. This fact suggests that the die cast community would exercise a high degree of care in reviewing die cast books and choosing die cast educational programs. However, the evidence shows that three members of NADCA exercised a low degree of care in reviewing email messages and were confused. (Allen Decl., Doc. No. 28, Skoff Decl., Doc. No. 29, Walker Decl., Doc. No. 31.)

Although this factor is inconclusive, "[t]he ultimate inquiry is whether, considering all the circumstances, a likelihood of confusion exists that consumers will be confused about the source of the allegedly infringing product." Hubbard Feeds Inc. v. Animal Feed Supplement Inc., 182 F.3d 598, 602 (8th Cir. 1999). Upon reviewing the evidence, the Court finds that five of the six factors weigh strongly in favor of Defendant. There is no genuine issue of material fact as to the likelihood of confusion in this case and Defendant is entitled to judgment as a matter of

law. Therefore, the Court recommends that Defendant's Motion for Summary Judgment on Counts I and II of the Counterclaim be granted.

B. **Counterclaim Count III: Anticybersquatting**

Count III of the Counterclaim asserts a claim that Plaintiff violated the Anticybersquatting Consumer Protection Act ("ACPA"), Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d). Section 1125(d) provides, in relevant part:

(d) Cyberpiracy prevention

> (1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person
>
> > (i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and (ii) registers, traffics in, or uses a domain name that-
> >
> > > (I) in the case of mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
> > >
> > > (II) in the case of a famous mark that is famous at the time of registration of domain name, is identical or confusingly similar to or dilutive of that mark; or
> > >
> > > (III) is a trademark, word, or name protected by reason of section 706 of Title 18 or section 220506 of Title 36.

15 U.S.C. 1125(d)(1)(A); see also Northland, 115 F.Supp.2d at 1123 (noting that to succeed under the ACPA claim a plaintiff must show that: (1) plaintiff's mark is distinctive or famous; (2) defendant's domain name is "identical or confusingly similar" to plaintiff's mark; and (3) defendant used, registered, or trafficked

in the domain name with a bad faith intent to profit from the sale of the domain name.) The first two factors are clearly met in this case. Defendant has two registered trademarks in NADCA and the NADCA logo. (Twarog Decl., Doc. No. 30, ¶ 9.) Plaintiff's domain name, "nadca.org" is nearly identical, and confusingly similar, to Defendant's registered mark.

As to bad faith, the ACPA provides nine nonexclusive factors to assist a court in assessing whether a party had the requisite bad faith intent. 15 U.S.C. § 1125(d)(1)(A). Five of the factors are relevant to our inquiry and include:

> (I) the trademark or other intellectual property rights of the person, if any, in the domain name;
>
> (II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
>
> (III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
>
> (IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
>
> (V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

15 U.S.C. 1125(d) (B)(i)

As discussed above, Defendant has an incontestable registered trademark in the name NADCA and the NADCA logo, and has used these marks consistently in its advertising, sales, and marketing since 1989. Plaintiff's legal name is not NADCA nor has Plaintiff offered any bona fide or fair use of Defendant's mark. Rather, the evidence clearly shows that Plaintiff intended to divert consumers from Defendant's site in attempt to tarnish and

disparage Defendant's mark. For example, Plaintiff sent email messages that were signed NADCA and sent these messages to NADCA members. (Allen Decl., Doc. No. 28, Skoff Decl., Doc. No. 29, Walker Decl., Doc. No. 31.) These email messages included a link to "nadca.org" and offered advertising opportunities, die cast classes and materials. (Id.) The signature line caused actual confusion and NADCA members testified to believing that Plaintiff was NADCA. (Id.) In addition the website vehemently criticized the NADCA president and proclaimed that Defendant's classes, materials, and die cast methods were based on principles that violated the laws of physics and then offered alternative classes and materials. (Compl., Ex. 21, Mem. in Opp., Ex. E.)

The evidence, including Plaintiff's own submissions and allegations, demonstrates that there is no question of material fact on Defendant's claim of cybersquatting, and Defendant is entitled to judgment as a matter of law. Therefore, this Court recommends that Defendant's Motion for Summary Judgment on Count III of the Counterclaim be granted.

C.**Complaint: Harassment and Declaration of Domain Name Ownership**

The Complaint seeks the following relief: (1) that Defendant be restrained from harassing the Plaintiff or his web provider, and (2) that the Court order that the domain name "nadca.org" belongs to the Plaintiff.[5] (Compl., p.3.)

For the reasons set forth above, the issue involved in Plaintiff's second claim for relief has been resolved in Defendant's favor. The Court finds that Plaintiff's use of "nadca.org" is likely to cause confusion and is in violation of the Lanham Act. There-

[5]Plaintiff also asserts that there were procedural mistakes made in the WIPO arbitration, specifically that (1) there was no reasoning given for the July 10, 2000, and the July 12, 2000, arbitration decisions, and (2) he was not given a copy of the opinion in readable format. (Compl. ¶¶ 11-15.) Plaintiff does not assert a prayer for relief for these alleged violations and the Court is unable assist Plaintiff in this matter. Furthermore, the Court notes that (1) the arbitration decisions did contain reasoning, (Counterclaim, Exs. A, B), and (2) the UDRP Rules require a copy of the decision to be published on a publicly available website. UDRP Rule 16(b).

fore, Plaintiff is not entitled to a declaration that "nadca.org" belongs to Plaintiff. As to the claim of harassment, the Court finds that the two allegedly harassing letters do not give rise to a cause of action because there is no legal or factual basis for such claims. (See Compl. Exs. A, B.) Nor is there a legal or factual basis for Plaintiff's final claims, as presented in his memorandum in opposition to summary judgment; in which he requests that the allegations of Mr. Allen, Mr. Skoff, and Mr. Walker be investigated for fraud and "Court contempt" as being "purely a shtick;" that Plaintiff be awarded costs, penalties, and attorneys fees; and that Defendant's Counterclaim be dismissed.

This Court recommends that Defendant's Motion for Summary as to claims set forth in the Complaint be granted and Plaintiff's Complaint be dismissed in its entirety.

D. **Damages**

Having determined that Defendant is entitled to summary judgment on the Counterclaim and the Complaint, the Court turns to the issue of damages.

Courts "shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title." 15 U.S.C. § 1116. As already mentioned, it is clear that Plaintiff has used Defendant's marks to deceive, or at least to confuse, the public. Defendant is entitled to injunctive relief against any further use of Defendant's trademarks. Therefore, the Court recommends that Plaintiff be permanently enjoined from (1) using or attempting to register the term NADCA, or any reproduction, copy, or colorable imitation or variation thereof, as part of a domain name on or in communication with advertising, distribution, sale or offering for sale of products or services; and (2) performing any other act that is likely to lead the public to believe that any product or service advertised, distributed, sold, or offered for sale by Plaintiff is licensed, sponsored, or approved by, or otherwise affiliated with, Defendant.

In addition, the Court also recommends that Plaintiff immediately transfer the domain name "nadca.org" to Defendant. See 15 U.S.C. 1125(d)(1)(c)(authorizing courts to order the forfeiture or cancellation of the domain name or transfer the domain name to the owner of the mark).

As a final matter, Defendant may seek monetary damages by electing to recover the infringer's profits, damages sustained, and costs of the action (15 U.S.C. § 1117(a)), or by electing an award of statutory damages in the amount of not less than $1,000 and not more than $100,000 (15 U.S.C. § 1117(a) or 15 U.S.C. § 1117(d). Defendant is required to make such a demand by Friday, May 25, 2001, after which the Court will establish a briefing schedule on this issue.

IV. **RECOMMENDATION** Based on the foregoing, and all of the records, files and proceedings herein, **IT IS HEREBY RECOMMENDED** that:

1. Defendant NADCA's Motion for Summary Judgment (Doc. No. 26) on the Counterclaim be GRANTED and that:

   (a) Plaintiff be permanently enjoined from using or attempting to register the term NADCA, or any reproduction, copy, or colorable imitation or variation thereof, as part of a domain name on or in communication with advertising, distribution, sale or offering for sale of products or services; and

   (b) Plaintiff be permanently enjoined from performing any other act that is likely to lead the public to believe that any product or service advertised, distributed, sold, or offered for sale by Plaintiff is licensed, sponsored, or approved by, or otherwise affiliated with, Defendant,

   (c) Plaintiff immediately transfer the domain name "nadca.org" to Defendant,

   (d) Defendant be required to present a more definite request for damages by Friday, May 25, 2001;

2. Defendant NADCA's Motion for Summary Judgment (Doc. NO. 26) on the Complaint be GRANTED; AND

3. Plaintiff's Complaint be DISMISSED WITH PREJUDICE.

Dated: May 21, 2001

/S /
Susan Richard Nelson
United States Magistrate Judge

Under D. Minn. LR 72.1(c)(2) any party may object to this Report and Recommendation within 10 days after being served with a copy thereof. The party shall file with the Clerk of Court, and serve on all parties, a writing which specifically identifies those portions of this Report and Recommendation to which objections are made and the basis of those objections. Failure to comply with this procedure may operate as a forfeiture of the objecting party's right to seek review in the Court of Appeals.

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .

Civ.No.00-1666(RHK/SRN)

ORDER

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant .

Civ.No.00-1737(RHK/SRN)

Plaintiff Genick Bar-Meir appeared pro se.

Debrea Staneck, Esq., (via telephone), and Dean Eyler, Esq., on behalf of Defendant North American Die Casting Association.

FILED Jun 12 2001
FRANCIS E. DOSAL, CLEARK
JUDGMENT ENTD _____
DEPUTY CLERK _____

SUSAN RICHARD NELSON, United States Magistrate Judge

The above-entitled matters come before the undersighned Magistrate Judge of the District Court on May 3, 2001, on several of Plaintiff Bar-Meir's motions. Each is discussed separately below.

A. Plaintiff's Motion to Impose Costs and Sanctions for Providing False or Misleading Disclosure in Civil File No. 00-1737 (RHK/SRN)

...

B. Plaintiff's Motion to Compel Responses to the Third Set of Requests for Production of Documents, and for and Award fo Sanctions in Civil No. 00-1737 (RHK/SRN)

...

C. Plaintiff's Motion for an Order Compelling Responses to the Third Set of Interrogatories and Requests for Production of Documents in Civil No. 00-1666 (RHK/SRN)

Plaintiff Bar-Meir moves for an order compelling Defendant NADCA to produce documents responsive to his Third Set of Interrogatories, Requests for Production of Documents, and Requests for Admission.

In light of this Court's recommendation that Civil Case No. 00-1666 (RHK/SRN) be dismissed, (see Report and Recommendation dated May 11, 2002, and Amended Report and Recommendation dated May 21, 2001), this motion is denied without prejudice pending Judge Kyle's ruling on Plaintiff's objections to the Report and Recommendation.

Based on the foregoing, and all the files, records and proceedings herein,

It IS HEREBY ORDERED that:

1) Plaintiff's Motion to Impose Cost and Sanctions for Providing False or Misleading Disclosure in Civil File No. 00-1737 (RHK/SRN) (Doc. No. 69)is DINIED AS TO THE MOTION FOR SANCTIONS, GRANTED IN PART AND DENIED IN PAART AS TO THE MOTION TO COMPLE, as set forth fully in the body of this Order at Section A;

2) Plaintiff's Motion to Compel in Civil File No. 00-1737 (RHK/SRN) (Doc. No. No. 72) is DENIED; and

3) Plaintiff's Motion to COmpel Production of Documents (THird Set) in Civil Case No. 00-1666 (RHK/SRN) (Doc. No. 57) is DENIED WITHOUT PREJUDICE.

Dated: June 12, 2001.

/S /
Susan Richard Nelson
United States Magistrate Judge

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Civil No. 00-1666(RHK/SRN)

Genick Bar-Meir
Plaintiff,

v.

NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant.

ORDER

Plaintiff has filed Objections to the May 21, 2001, Report and Recommendation of Magistrate Judge Susan Richard Nelson. The undersigned has conducted the required de novo review of the Objetions to the Report and Recommendation, and is satisfied that Judge Nelson's resolution of the issues before her was correct. Accordingly, the Report and Recommendation will be adopted in its entirety.

Upon all the files, records and proceedings herein, IT IS ORDERED:

1. The Objections (Doc. No. 65) are OVERRULED;

2. The Report and Recommendation (Doc. No. 62) is ADOPTED;

3. Defendant NADCA's Motion for Summary Judgment (Doc. No. 26) on the Counterclaim is Granted and

   (a) Plaintiff is permanently enjoined from using or attemptin to register the term NADCA, or any reproduction, copy or colorable imitation or variation thereof, as part of a domain name ofor in communication with advertising, distribution, sale or offering for sale of products or services,

(b) Plaintiff is permanently enjoined from performing any other act aht is likely to lead the public to believe that any product or service advertized, distributed, sold, or offered for sale by Plaintiff is licensed, sponsored, or approved by, or otherwise affiliated with, Defendant,

(c) Defendant is required to present a more definite request for damages by Friday, May 25, 2001; and

4. Defendant NADCA's Motion for Summary Judgment (Doc. No. 26) on the Complaint is Granted; and

5. Plaintiff's Complaint is DISMISSED WITH PREJUDICE.[1]

Dated: June 12, 2001

/S /
RICHARD H. KYLE
United States Judge

[1]The Court Reserves jurisdiction with respect to damages claimed by Defendant.

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Civil No. 00-1666(RHK/SRN)

Genick Bar-Meir
Plaintiff,

v.

NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant.

ORDER

Before the Court is Plaintiff's Motion for Stay While Pending Appeal. The Court is of the Opinion that (a) Plaintiff will not prevail on the appeal; (b) Plaintiff will not suffer irreparable harm if the stay is not granted; (c) Defendant will clearly be harmed if the stay is granted; and (d) a stay is not in the public interest.

Based on the foregoing, and upon all the files, records and proceedings herein, IT IS ORDERED that Plaintiff's Motion for Stay While Pending Appeal (Doc. No. 76) is DENIED.

Dated: June 25, 2001

/S /
RICHARD H. KYLE
United States Judge

UNITED STATES DISTRICT COURT
DISTRCIT OF MINNESOTA

Genick Bar-Meir
Plaintiff,
v.
NORTH AMERICAN DIE CASTING ASSOCIATION,
defendant.

Civil No. 00-1666(RHK/SRN)

ORDER

By Order dated June 12, 2001, this Court granted Defendant's summary judgment motion and dismissed, with prejudice, the Complaint. In the same Order, the issue of damages claimed by Defendant was "reserved." Notwithstanding that the Order did not contain a Rule 54 (b) direction to the Clerk for the entry of a judgment, Judgment in a Civil Case was entered by the Clerk on June 12, 2001.

Being of the view that the entry of judgment was a clerical error, the Court hereby VACATES the Judgment in a Civil Case (Doc. No. 73), and the Defendant's claim for monetary damages will be resolved in due course.

Dated: August 15, 2001

/S /
RICHARD H. KYLE
United States Judge

United States Court of Appeals
FOR THE EIGHTH CIRCUIT

No. 01-2534

**
**

Dr. Genick Bar-Meir Appellant, v. North American Die Casting Association, Appellee.	*	Appeal from the United States District Court for the District of Minnesota. [UNPUBLISHED]

Submitted: December 26, 2001
Filed: January 10, 2002

Before BOWMAN, BRIGHT, and LOKEN, Circuit Judges.

PER CURIAM.

Genick Bar-Meir filed this action against the North American Die Casting Association (NADCA), requesting an order that the domain name "nadca.org" should remain with him. NADCA filed counterclaims under the Lanham Act, 15 U.S.C. § 1051 et seq., seeking injunctive relief to prevent Bar-Meir from using the term "NADCA" and to transfer the domain name to NADCA. The district court[1] granted NADCA's motion for summary judgment on its counterclaims, permanently enjoined Bar-Meir from

[1]The Honorable Richard H. Kyle, United States District Judge for the District of Minnesota, adopting the report and recommendations of the Honorable Susan Richard Nelson, United States Magistrate Judge for the District of Minnesota.

using the term "NADCA," ordered Bar-Meir to transfer the domain name "nadca.org" to NADCA, and dismissed Bar-Meir's complaint with prejudice. The district court has not yet resolved NADCA's claim for damages. Bar-Meir appeals.

We have jurisdiction to review the district court's interlocutory order granting both the injunction, see 28 U.S.C. § 1292(a), and summary judgment, see Randolph v. Rodgers, 170 F.3d 850, 856 (8th Cir. 1999)(court may review issues inextricably bound up with injunction). We conclude that the district court correctly granted summary judgment on NADCA's counterclaims under sections 32(1)(a) and 43(a)(1) of the Lanham Act, as the relevant factors support the court's finding that a likelihood of confusion exists from Bar-Meir's use of the NADCA trademark. See 15 U.S.C. §§ 1114(1)(a), 1125(a)(1); Luigino's, Inc. v. Stouffer Corp., 170 F.3d 827, 830 (8th Cir. 1999)(discussing factors). We also conclude that summary judgment was proper on NADCA's counterclaim for cybersquatting, as the statutory factors point to Bar- Meir's bad-faith intent to profit from the mark. See 15 U.S.C. § 1125(d)(1)(A), (d)(1)(B)(i). Thus, we hold that the district court did not abuse its discretion in issuing a permanent injunction, see 15 U.S.C. § 1116(a); Randolph, 170 F.3d at 856 (standard of review), and we affirm. We dismiss the appeal as to the remaining orders, as those issues are not properly before us.

A true copy.

Attest:

CLERK, U.S. COURT OF APPEALS, EIGHTH CIRCUIT.

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Genick Bar-Meir, plaintiff v. North American Die Casting Association, Defendant. Case No. 00-1666 RHK/SRN
Judge Richard H. Kyle Magistrate Judge Susan Richard Nelson

DECLARATION OF GARY G. WALKER

I, Gary G. Walker, declare and state as followings:

1. I have personal knowledge of the matters set forth in this declaration which I am providing in connection with the defendant and counter-plaintiff North American Die Casting Association's ("NADCA") motion for summary judgment.

2. I am the former President of Contech Division of SPX Corporation ("SPX/Contech"). SPX/Contech is a die casting business located in Portage, Michigan. I personally have been a member of NADCA since its formation, and SPX/Contech has been a corporate member since that time. As such, I am aware that NADCA offers a wide variety of training and educational course and that NADCA communicates with its members via broadcast e-mail messages.

3. Sometime in late December 1999 or January 2000, I received an e-mail message that identified the sender as an individual at "nadca.org." The text of the message described an educational program relating to die casting. The message was typical of other NADCA broadcast e-mails that I have received from NADCA announcing education programs. As President of SPX/Contech, I have found NADCA's course to be an good investment. We often send newly-hired engineers to these training classes.

4. Because I believed that this message was from NADCA, I forwarded it to my engineering managers, application scientists, and possibly others at my company asking them to consider sending some of our newly-hired engineers to the program that was described in the message.

5. It was only after I had forwarded the message with the recommendation that we consider sending our employees to the program descried that I learned that the message was not from NADCA at all but was from Genick Bar-Meir. In my view, Dr. Bar-Meir's e-mail message mimicked NADCA's broadcast e-mail messages.

6. At least one later e-messages from Dr. Bar-Meir referenced SPX/Contech in a way that I felt falsely suggested that my company was endorsing or was somehow associated with the "nadca.org" courses or web site. Attached is a copy of a message that mentions SPX/Contech's name in his messages.

I declare under penalty of perjury that the foregoing is true and correct.

Dated January 4, 2001 /S/ Gary G. Walker

Extaxtes from Walker Depostion Gary Walker

p. 104

Q What kind of activity actually you wanted to end?

A What does sentence refer to Dr. Bar-Meir?
amybe you can can clarify that.

Q Do you recall what kind of activity that you want to end through your organization? MS. STANEK: Objection because the witness doesn't have the document in front of him, but if he remembers, please answer.
THE WITNES: I'm not sure what that activity was. I believe it was anything that would is had anything to do with your organization. We weren't doing anything with you or your organization. When I say "we" I'm referring to Contact, SPX Corporation Contact, the company I ran for umpteen years. I was directing my people if they were doing anything within your organization and I was going to try and find that out, we were to end that activity.
That's that pulling the plug means.

BY DR. BAR-MEIR

Q May I ask what was the reason that you wanted to end this activity?

A Based on the lawsuit that - - The discussinons and the description that you had made of NADCA as being a corrupt organization, I didn't want to do business with anybody who would make those accusations, make those liable slanderous accusations against the organization of which I was the chairman. I was not going to have any of my people doing business with anybody associated with your organization. Dr. Bar-Meir's organization.

Q You referring to activity of learning Dr. Bar-Meir or - -

A Any contact whatsoever.

Q Please. Just a second. Let me finish my question.
Are you referring to activity such as utilizing Dr. Bar-Meir idea?

A Dr. Bar-Meir, read my lips. I would not allow my people to do business with you in any shape or manner. That's what pulling the plug calls for.

Q I'm not really sure if you referring to business as utilizing - - going to seminar or referring to using idea.

A I don't know what ideas you're talking about.

extracts from P. 112

DR. BAR-MEIR: I didn't hear the answer.
The WITNESS: answer is we would not pay for services. As far as ideas are concerned, that was not the intent of my E-Mail or my direction.

BY DR. BAR-MEIR:

Q You were under the impression that his service cost money, is that correct?

A Yes.

Q Did you read the announcement about the class?
MS. STANEK: Objection. Irrelevant. Let's get to the defamation issue.
DR. BAR-MEIR: That's the defamation issue.
THE WITNESS: Did I read the announcement about the class?
I certaintly read the announcement, but I don't recall the details of it.

BY DR. BAR-MEIR:

Q You read the announcement - -
MS. STANEK: Asked and answered.

BY DR. BAR-MEIR:

Q But you don't remember the detail, is that correct?

A I have not seen the announcement since it was sent to me.

extract from p. 114

Q Let me repeat one more question abut eh confusion that you have.
Was that confusion about the book or class or seminar?

A - Confusion was about neither, Doctor.

These are the letters that Mr. Walker received and sent to the petitioner:

letter dated December 27, 1999

From: Genick Bar-Meir [SMTP:genick@nadca.org]
Sent: Monday, December 27, 1999 12:50 PM
Subject:

Open Letter to Mr. Twarog, North
American Die Casting Association's
president (NDC)

To: Daniel L. Twarog, North American Die Casting Association's president
9701 West Higgins Road, Suite 880
Rosemont, IL 60018-4721

Date: December 16, 1999
Subject: Why are you trying to get me fired?

Dear Mr. Twarog:

I am the scientist who made the most progress in the understanding of the die casting process and wrote the best book on die casting process entitled "Fundamentals of Die Casting Design" which is available for downloading (www.nadca.org). In the last four years, I have been trying to make all these scientific advances available to the die casting community through the North American Die Casting Association and otherwise. Unfortunately, all my efforts to make this information available were unfruitful. Check my open letter to Mr. Steve Udvardy and my correspondence with your Editor at the time, Mr. Paul Bralower. Then, when I exhausted all other means to make this information available to the die casting community, I open a web site "www.nadca.org." To repel this web site, you sent a letter to the president of the University of Minnesota to get me fired.

I phoned you on December 9th, 1999 hoping that we could cooperate, just to learn that you are trying to get me fired! Why?

Why didn't you talk to me? All I get from you is that it isn't ethical and appropriate to let other people know what is going on. Let me tell you as loud as I can: "I have done nothing wrong!" You mentioned that you appointed a committee of three "experts" to study my book and "inconsistencies" in your classes. Here, I thought, perhaps, you are willing to cooperate by accepting/checking the new technologies to promote the die casting industry.

I decided to shutdown my web site temporarily because I assumed that it already achieved my objectives. However, you interpret my actions as a weakness or you believed it is due to the president of the University of Minnesota. Thus, you decided not to inform the die casting community about your committee. Why? Additionally, you also change your decision to cooperate with me. Don't you think that it is important for your organization to cooperate with the scientist/s who make more progress to the die casting industry than anyone else? Please do not be hostile to the science. Please do not make a committee to study your "inconsistencies" forever.

You claim that both of us are right. Please do not elute the die casting community that my scientific findings can coexist with North American Die Casting Association's teaching. They are not! Let me make it crystal clear. There is no possibility for B to say that both A and B are right when A says that B is wrong; only one can be right. Please acknowledge that you could not find anyone in the last four years who can prove my technologies to be wrong.

Please help the die casting community to make the right choice and learn the right material. Please let the die casting community know that you are not sure about your teaching material. Please let the die casting community know that you continue teaching it because ..... well, I am not sure why. Maybe you can explain it? I am begging you to suspend your classes until at least you finish your investigation.

Here what I am pleading you: Let all of us discuss these technical issues with your "experts" (please make their names publicly available). I am not afraid to say that I am wrong when I am. Please contact me if you genuinely want to work together

to promote the die casting industry. I will help anyone or any organization that has the same interest. Please do not go behind my back to prevent me from promoting the die casting industry. I ensure you that once you cooperate with me you will see the benefits for the die casting industry as well as your organization. Please show interest/cooperation with/to the outstanding researchers.

I invite you and/or anyone in your organization to contribute to my web site. If you feel that you want to add or critic anything that bothers you, please send it to me and I will post it in my web site (please consider the fact that it is a public place).

Sincerely,
Dr. Genick Bar-Meir

cc: your Board of Governors, your members, Anyone who care about die casting industry

Mr. Walker answer the message and attached the previous message as well.

From gwalker@spxcontech.com Tue Jan 4 10:43:32 2000
Received: from smtp.spxcontech.com
(m58.contech.isdn.net-link.net [207.49.230.82])
Message-Id: <s871dd4f.052@smtp.spxcontech.com>
From: "Gary Walker" <gwalker@spxcontech.com>
To: <genick@nadca.org>
Cc: <Mdcast@aol.com>, <Twarog@diecasting.org>,
<bluridge@ptd.net>,
<bbutler@usedsmta02.inushub.eds.com>
Subject: Re:

Sir:

If your views cannot be accepted by the organization representing the die casting industry then perhaps you should move on to a different industry. Our members decide who's work should and should not be recognized. That's the procees. If they decide that your work is not worthy of such recognition then I support that.

Your actions past and present are less than professional as has been expressed by many people in the industry. Should your actions warrant reprimand by your employer then so be it. Certainly, in the private industry your conduct would be classified at the very least as radical.

Clearly, you will find no support in this quarter. Kindly remove my name from your mailing list.

Gary Walker
President, SPX CONTECH
Past Chairman and **President** of NADCA

Attachment form Genick Bar-Meir <genick@nadca.org> 12/27 12:40 PM >¿>
Open Letter to Mr. Twarog,
North American Die Casting Association's president (NDC)

a personal letter to Mr. Walker.

Dear Mr. Walker,

I am sorry that I was not able to admit your engineer to my class. As you know I am have limited time and space. I would like to assure you that your actions against science and scientists such as me are not the reasons for this. I understand that you were under the illusion that North American Die Casting Association is really helping the die casting industry. I have made a space your your engineer in the next class. I hope that your "conversion" to believe in science remove your hostility as well against me.

Cheers,

Genick

automatic letter generated by Walker's personal computer to refuse the letters from Dr. Bar-Meir

Note the same machine (web address) as before.

Received: from smtp.spxcontech.com
(m58.contech.isdn.net-link.net [207.49.230.82])
by bullwinkle.itasca.net (8.8.8/8.8.8/Debian/GNU)
with ESMTP id PAA17375 for <genick@nadca.org>;
From: gwalker@spxcontech.com
Subject: Email **Refused**
To: nadca <genick@nadca.org>
X-Mailer: Lotus Notes Release 5.0a May 4, 1999
Message-ID: <OF4BAE5792.F69E6E15-
ON852568BF.0071C5E8@spxcontech.com>
X-MIMETrack: Serialize by Router on Portage/contech
(Release 5.0.2c —February 2, 2000)
MIME-Version: 1.0
Content-type: text/plain; charset=us-ascii
Status: RO

the eduction material offer that allegedly confused Mr. Walker in the end of December, 1999

From: nadca <genick@nadca.org>
Sent: Saturday, February 19, 2000 1:32 AM
Free On Line Die Casting Design Classes

Here is what the North American Die Casting Association claim: " their teaching is almost as good as ours(check www.nadca.org/coverup.html)." YOU WILL BE JUDGE!

Network Advance Die Casting Assistance is proud to offer free classes to die casting engineers and die casting community in general. The first class to be offered is: "Introduction to runner system design." All you have to do is to register the class before March 27, 2000 via email.

Class notes will be email to you. You can send questions or/and discussions to Dr. Bar-Meir-Meir. There is a limit on the number of the students. So please register as early as possible.
Tentative Classes to follow:
intermediate runner design
advance runner design
special topic in runner design
introduction to pQ2 diagram
intermediate pQ2 diagram
advance pQ2 diagram
Application pQ2 diagram
Shot Sleeve process design
Introduction to die casting venting system design
Heat transfer in the die casting cooling system
Application of the cooling system control

Please pass this information to anyone who might be interested in gaining knowledge of die casting design.

Thanks,

NADCA

The last message followed by this one

This message was never sent to Mr. Walker but he made the allegations that he received it.

From genick Thu Feb 24 12:19:34 2000
From: nadca <genick@nadca.org>

Dear Sir/Madam:

Due to the overwhelming response (only 35 students can be accepted) to our online free classes, we do not accept any further registrations until the next class. We already have a waiting list and we encourage you to register earlier if you are planing to take any classes in the next six months.

We have students from several countries such Germany, Italy, Japan, Taiwan India, Canada, and USA. Some come from large companies such as Honda Corporation while others come from a very small enterprise. Some applicants come from companies that have a representative in the board of Governors of the North American Die Casting Association for example Pemco Diecast, Contech/SPX (previous chair and president).

There is next class, so please be patient.

We are on a mission to insert Science into the die casting.

Cheers,

NADCA
www.nadca.org

A letter Mr. Allen sent to Mr. Twarog two months before he alleged that he got confused

Subject: G. Bar-Meir Communication
Author: tjallen@pemcodiecast.com (Terry Allen)
Date: 12/9/99 5:45 PM

Hi Dan!

By now I'm sure you have a copy of the communication form Genick Bar-Meir which apparently went to many of us. I've had one or two diatribes from him in the past, but never so targeted at NADCA. and individuals within NADCA.

I've tried to open his "book" which I downloaded from his "NADCA.org" web site, but apparently lack of proper program.

Is this character for real? Or is he just trying to extort NADCA into buying his domain name? (I always wondered why we didn't have "NADCA.com" or "NADCA.org"nailed down. Now I know!)

I suspect that you and staff are dealing with inquiries from others on this. I'd think that some kind of a backgrounder or summary to help me understand the situation, and to allow me to respond if questioned by members - either within PEMCO or in this area - would be of assistance.

Nothing immediate is necessary, but you may want to be sure that the members of the Board of Governors have the background and an understanding of what he's reiling on about. In most cases, I've found that there are little bits of fact surrounded by a whole lot of fiction (and friction!) in matters like this. I could help to have us know what's real and what's not.

Thanks! Terry

Lanham Act

§ 1125(a), which provides:(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination hereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which– (A) is likely to cause confusion, or to cause mistake or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(d)(1)(A). In order to determine whether someone has acted in bad faith under the ACPA,

a court may consider factors such as, but not limited to

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of this section.